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Supreme Court, U.S.
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IN THE

Supreme Court of the United States

AVERY DENNISON CORPORATION,

Petitioner,

v.

3M INNOVATIVE PROPERTIES COMPANY and
MINNESOTA MINING & MANUFACTURING COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Is an express determination by the Patent Office during the patent examination process regarding the format of claims used by the applicant and the scope of patentable rights thereby created entitled to the deference normally accorded an administrative agency's conclusions when federal courts construe the scope and meaning of patent claim terms, or may that determination be wholly ignored, as the Federal Circuit did below, whenever the patent applicant does not affirmatively express concurrence, in writing, during the examination process?

2. Was the Federal Circuit correct in finding that past tense verb terms, frequently used as adjectives in product claims, descriptive both of structure and the way in which the structure is created, must be construed as "entirely structural" only, without any consideration of the process inherent in the claim language selected by the applicant, even when such terms communicate no identifiable structure in addition to the structure already provided by other limitations in the claim?

LIST OF PARTIES

The parties in the court below are listed in the caption. Pursuant to Rule 29 ¶ 6, petitioner Avery Dennison Corporation has no parent corporation, and no publicly held companies own 10 percent or more of its stock. Its subsidiary corporations, not wholly owned, are as follows:

Avery Dennison Health Management Corporation — USA

Avery Dennison-Maxell K. K. — Japan

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Petitioner Avery Dennison Corporation ("Avery") respectfully requests that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit in *3M Innovative Properties Co. v. Avery Dennison Corp.*, 350 F.3d 1365 (2003).

OPINIONS BELOW

The opinion of the Federal Circuit is reported at 350 F.3d 1365, and is reprinted in the Appendix to this Petition ("App.") at 1a. The principal opinion of the United States District Court for the District of Minnesota is reported at 2002 WL 31628395 (D. Minn. Oct. 19, 2002), and is reprinted at App. 24a. The other relevant opinion of the District Court is reported at 185 F. Supp. 2d 1031, and is reprinted at App. 39a.

STATEMENT OF JURISDICTION

The decision of the Federal Circuit in this case was entered December 2, 2003. A timely petition for panel rehearing and, alternatively, for rehearing en banc was denied on January 20, 2004. App. 62a. The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

The provisions of 35 U.S.C. § 112, 35 U.S.C. § 271, and 5 U.S.C. § 706 are found at App. 64a.

STATEMENT OF THE CASE

This case presents two important legal questions, each with far-reaching ramifications for federal patent policy and litigation, and each wrongly decided by the United States Court of Appeals for the Federal Circuit:

> (1) whether federal courts, in construing the claims of issued patents, must give deference to conclusions reached by the Patent Office—the administrative agency responsible for making patentability determinations—regarding the format of claims and the scope of exclusive rights thereby conveyed.
>
> (2) what is the proper way in which federal courts should construe product claims that have process limitations—descriptive both of structure and the way in which the structure is created.

The split decision below would not have occurred if the body of patent law relating to claim construction successfully promoted the fair notice requirement of the Patent Act.

The Federal Circuit reverses nearly one-half of all claim construction decisions presented on appeal. This reversal rate is symptomatic of the public's inability to predictably determine the legal scope of patent claims. Significantly contributing to this uncertainty is the Federal Circuit's refusal to give any weight to the Patent Office's pronouncements upon examining patents regarding the type of claim format used by patent applicants and the scope of the claimed invention thereby created.[1] According to the Federal Circuit's decision below, unless a patent applicant affirmatively expresses agreement to such a Patent Office determination

1. Types of claim formats include "product-by-process" claims, "means-plus-function" claims, etc.

in writing during the examination process, federal courts may freely substitute their judgment about claim format and scope over that of the expert agency charged with the determination of patentability. This rule not only denies the public fair notice of a patentee's proprietary rights, it directly contravenes the deference Congress and this Court demand for agency determinations.

Representatively, and in this case, the Federal Circuit's refusal to give deference to the Patent Office's conclusions about claim format and scope directly led to an absurd result. In allowing claim 1 of the patent at issue, the Patent Office expressly found the claim written in the "product-by-process" format based in part on the applicants' use of the term "embossed" throughout the patent specification to describe how the claimed product—a "carrier web"—is made. Yet the Federal Circuit gave no weight whatsoever to the Patent Office's conclusions. The Federal Circuit not only refused to defer to the expert agency's determination that the applicants had elected the "product-by-process" claim format (which the Patent Office then used to evaluate patentability), it found just the opposite: that the claim language used was "entirely structural," without any process limitation inherent in the selected terms. The Federal Circuit's decision in this regard substantially expanded the scope of the exclusive rights that both the Patent Office believed—and the public reasonably understood—had been conferred upon the applicants by the Patent Office.

Factual Background

This case involves U.S. Patent No. 5,897,930 (the "'930 patent), which was issued and assigned to Minnesota Mining and Manufacturing Company ("3M") in 1999. [A0041.][2]

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2. The Appendix in the Federal Circuit is cited by page number as "Axxxx."

The '930 Patent describes "multiple embossed webs" useful as liners for pressure sensitive adhesives and for other industrial applications. [A0044 (1:4-6).] When used for commercial graphics, pressure sensitive adhesive products provide a substitute for painting, signs, logos, and advertisements. [A0002.] Similar to a large bumper sticker, the graphic film is printed on one side. On the other, a "carrier web" or release liner is coated with an adhesive and attached to the film. Removing the release liner exposes the adhesive so the film can be affixed to the intended surface. [*Id.*]

Like wallpaper, two features can make applying graphic films easier: (i) the ability to position the film before the adhesive takes hold and (ii) the ability to remove trapped air. [A0044, (1:15-30).] 3M's '930 patent purports to solve these problems by embossing a carrier web twice, with two different patterns. The first embossed pattern forms tiny depressions or dimples in the carrier web surface. As explained in the patent, these depressions can be filled with small particles (such as glass beads) before the adhesive is applied. [A0045-46.] Upon removing the carrier web from the film, the beads transfer with the adhesive to form small protrusions, which come into contact with the application surface before the adhesive takes hold so the film can be positioned more easily. [*Id.*] The second embossed pattern consists of a larger pattern of "lands and ridges." The ridges from the second embossed pattern form channels in the adhesive, which allows the air to escape during application. [A0046-47.]

When 3M applied for the patent, it conceded that the disclosed method for achieving positionability through embossed depressions was already known in the art; indeed, the same 3M inventors had patented the method. [A0044.] Likewise, embossing or roughening surfaces to create air egress channels was already known in the art as well—Avery

had disclosed this feature in a patent 15 years earlier. [A1001.] The Examiner also cited art showing embossed patterns, made simultaneously, but occupying different levels. [A0102-103.] Although 3M's disclosed methods for solving both the positionability and air egress problems were already known, as were simultaneously-made embossments of different patterns at different levels, 3M argued that it still disclosed patentable subject matter. Specifically, 3M asserted to the Patent Office that no one had earlier divined how to emboss the same material twice, where the first embossed pattern "survives" a subsequent embossing to form two distinct patterns of "differing depths of embossing." [A0112.][3] To further clarify the purported invention as a sequentially embossed carrier web and to overcome a vagueness objection for the product claim (claim 1), 3M amended the product claim 1 by incorporating terms from a parallel method claim (claim 8), which recited the two separate embossing steps. [A0111.]

After 3M distinguished its invention as two separately embossed patterns from the prior art, which described two different embossed patterns made at the same time, the Examiner expressly concluded that 3M had drafted its

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3. Oddly, the Federal Circuit, in overruling the District Court's finding that the '930 patent is limited to sequential embossing of two different patterns, dismissed these admissions by 3M as not disavowing claim scope because 3M's statements were "broader than necessary to distinguish the prior art. . . ." App. 15a. But 3M could not have distinguished the prior art without clarifying that its invention was limited to sequentially embossed patterns where one pattern survives a subsequently embossed pattern: The Examiner had rejected the claims based on known art showing not only a single embossed pattern, but different embossed patterns—***made simultaneously***—occupying different levels of depth. Thus, merely saying that its invention encompassed two patterns regardless of the number of steps would not have distinguished the prior art.

product claims in the "product-by-process" format.[4] [A0121.] Nonetheless, the Examiner again rejected the claims, citing at least four prior art references showing two separately-made embossed patterns on the same surface. [A0121-0124.] In response, 3M did not challenge the Patent Office's conclusions about the "product-by-process" format. It remained silent. 3M thereafter amended all claims by adding a specific height limitation for the ridges formed by the second embossed pattern. [A0128-0130.] With this amendment, the Patent Office allowed the claims. [A0133.]

Well before 3M's '930 patent issued, Avery had begun work on its own graphic film with a liner having positionability and air egress features. Not surprisingly, considering what was already known in the art, Avery had experimented with double embossed liners. Avery had also tested ways of achieving positionability through ways other than embossing, such as printing and impressing small, hardened, polyurethane ink "dots" into the top layer of a liner made from polyethylene. When separating the liner from the film, Avery found that the ink would separate from the polyethylene, and transfer onto the adhesive surface as non-tacky bumps to improve positionability. [A2241-42.] Avery further determined that the liner with embedded ink could be embossed to create air egress channels, and that the embossing and ink embedding could occur simultaneously. After demonstrating positionability and air egress from a printed and single embossed liner, Avery sought patent protection for its new invention.

When 3M's '930 patent issued, Avery's engineers studied the '930 patent and its file history, and consulted legal counsel about what products it could bring to market while respecting

4. A "product-by-process" claim "is one in which the product is defined at least in part in terms of the method or process by which it is made." *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 159 (1989).

3M's patent rights. Avery took 3M at its word. 3M's repeated use of the word "embossed" in the product claims, 3M's repeated use of the word "embossed" in its ordinary and customary usage throughout the '930 patent specification, 3M's express definition of embossed in the specification, which, although ambiguous, was reasonably susceptible to the ordinary and accustomed meaning of the term, and the Examiner's express statements that the product claims were drafted in "product-by-process" format requiring two, separately-made embossed patterns, caused Avery to reasonably conclude its independently, developed single embossed film did not infringe the '930 patent. Accordingly, Avery began selling the printed and embossed film as "EZ Film." [*Id.*]

On September 27, 2001, 3M sued Avery for infringement of its '930 patent in the United States District Court for the District of Minnesota based on the sale of Avery's competing EZ Film. [A0053.] The case was assigned to the Hon. David S. Doty.

Denial of 3M's Preliminary Injunction Motion

On October 15, 2001, 3M moved for a preliminary injunction to remove Avery's EZ Film from the market, leaving 3M with a complete monopoly on positionable/air egress graphic films. [A0436.] In seeking a preliminary injunction (which 3M based solely on product claim 1 of the '930 patent), 3M recited the law that "'terms in the claim are to be given their ordinary and accustomed meaning,' absent some indication in the patent to the contrary." [A0452, citing *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999).] 3M did not say that the '930 patent contained any indication of a meaning for claim terms such as "embossed" and "multiple embossed" other than their "ordinary and accustomed" meaning. To the contrary, 3M argued that the District Court should apply the "plain meaning" of the claim terms used, and that its motion

presented "no difficult issues of claim construction. . . ." [A0452.][5]

Finding that 3M had no likelihood of success on the merits, the District Court denied 3M's motion for a preliminary injunction. [A0001-0023.] In making that finding, the District Court construed the relevant patent claims. It first examined the phrase "multiple embossed pattern." Consistent with the Patent Office's conclusion that 3M had elected the "product-by-process" format for claim 1, the claim language itself, the specification's definitions, as well as nearly a dozen statements from the specification and file history, Judge Doty concluded that "multiple embossed pattern" means sequential embossing patterns—*i.e.*, "a second embossed pattern following a first embossed pattern." [A0010-14.] Next, Judge Doty considered the phrase "first embossed pattern . . . of depressions" from claim 1. Looking at the definition of "embossed" contained in the specification, and accepting 3M's concession that the ordinary and accustomed meaning applied, Judge Doty adopted a plain, process-oriented construction of the word "embossed," consistent with the product-by-process format of claim 1—"a topography created on material by impressing a corresponding inverse topography on its surface." [A0015-

5. The specification for the '930 patent contains definitions for "embossed," "pattern," and "multiple embossed." But just because a patent includes definitions for terms does not mean, *ipso facto*, that the patentee intended definitions different from the ordinary and accustomed meaning. In fact, the Federal Circuit has held that definitions differing from the ordinary and accustomed meaning must clearly be set forth. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) ("Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision."). Nonetheless, the Federal Circuit's decision below not only assumes, without any analysis, that the definitions provided in the patent specification differ from the ordinary and accustomed meaning, but overlooks 3M's judicial admissions that the claim terms carry no specialized meaning. App. 11a.

16.] Based on these constructions, Judge Doty concluded that 3M had no likelihood of proving infringement against Avery's EZ Film: Unlike 3M's claimed web with two, sequentially-embossed patterns, Avery's accused EZ Film liner contains only one embossed pattern on a composite top layer consisting of polyethylene and embedded ink. [A0018.]

The District Court's Non-Infringement Summary Judgment Ruling

On October 19, 2002, Judge Doty granted Avery's motion for summary judgment of non-infringement, finding that Avery's EZ Film liner did not infringe 3M's '930 patent, as a matter of law, either literally or under the doctrine of equivalents. [A0025-0039.] In considering infringement, Judge Doty applied the constructions of "multiple embossed pattern" and "embossed" from the order denying a preliminary injunction. [A0033.] Applying these constructions, Judge Doty rejected 3M's imaginative, lawyer-created argument that embedding polymer ink into the top polymer layer of a multilayered liner—forming a flush copolymer top surface—created an "embossed pattern . . . of depressions" in the liner. [A0033-34.] Likewise, Judge Doty rejected 3M's equally-creative argument that the polyurethane ink itself—pre-printed on the liner surface—acts as an "embossing tool" when embedded into the upper polyethylene layer of the liner. [A0034-0035.] Among other things, Judge Doty found that embedded ink lacked any characteristic of an embossing tool, and that a composite liner top-layer, consisting of polyethylene encasing polyurethane ink in a flush surface, hardly resembled an "embossed" pattern of "depressions." [*Id.*] Because Avery's EZ Film liner utterly lacked one of the key elements recited in each claim—namely, the "first embossed pattern" of "depressions"—Judge Doty found no possible basis for infringement under the doctrine of equivalents. [A0035-0038.]

Following the grant of summary judgment, the parties stipulated to the resolution of other matters, and on December 6, 2002, the District Court entered judgment against 3M pursuant to Fed. R. Civ. P. 58(1).

The Federal Circuit's Ruling

On appeal, 3M attacked Judge Doty's claim construction rulings, which had dated from the denial of a preliminary injunction. The Federal Circuit, in a 2-1 panel decision, agreed that Judge Doty erred in construing the claims, reversed the judgment and remanded for an infringement determination under the Federal Circuit's new claim constructions. App. 18a. On January 20, 2004, the Federal Circuit rejected Avery's timely petition for Panel Rehearing and, Alternatively, for Rehearing En Banc. App. 62a.

First, the Majority disagreed that the phrase "multiple embossed pattern" as used in claim 1 required that the patterns be created sequentially, or that claim 1 contained a temporal limitation regarding the creation of the two embossed patterns in any respect. App. 12a. Instead, the Majority construed claim 1 as "entirely structural," finding no limitation on the order in which the two patterns are created on the claimed web. App. 16a. In reaching this decision, the Majority gave no weight whatsoever to the Patent Office's conclusion that the applicant had drafted claim 1 using the "product-by-process" format. App. 15a-16a. Further, the Majority found no acquiescence by the applicant's silence in response to the Examiner's stated conclusion that product claim 1 was written in "product-by-process" format:

> In this context, the examiner's statement does not constitute a clear and unmistakable surrender of claim scope. An applicant's silence in response to an examiner's characterization of a claim does

> not reflect the applicant's clear and unmistakable acquiescence to that characterization if the claim is eventually allowed on grounds unrelated to the examiner's unrebutted characterization.

Id. (citations omitted).[6] Under this rule, what the Patent Office concludes and publishes to the world in the file history about claim format as a basis for granting exclusive rights in a patent make no difference: a patentee can later assert, and a court can grant, broader rights so long as the patent applicant has not affirmatively "acquiesced" in the Patent Office's determination.

Second, the Majority determined that Judge Doty erred by defining "embossed" in a manner that imposed a "process" requirement into the term. App. 16a-17a. According to the Majority, the inventors defined "embossed" in the specification in "entirely structural" terms. *Id.* Arguably, 3M's patent rights could extend to any web containing a "three-dimensional" surface "topography"—even if the web had never been embossed.[7] To support the conclusion that claim

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6. 3M did not merely remain "silent" in response to the Patent Office's conclusions about claim format. After amending its claims in response to prior art rejections to make the process features of its product claims unambiguous, 3M did not dispute the Examiner's subsequent confirmation of the "product-by-process" format. Rather, 3M tacitly accepted the Patent Office's determination of claim format and, to overcome additional prior art, added the height limitation for the ridges formed by the second embossed pattern. [A0128-131.]

7. The Majority explained that "[t]he patent does not limit *how* the embossed pattern, as defined in the specification, is created." App. 17a (emphasis in original). While the patent allows for embossing the web in any manner known in the art, the majority's construction takes matters a step further: If "embossed" means only a structural topography, without any inherent process limitation requiring the impression of one surface upon another (as the District (Cont'd)

1 must be read as structural only, without any consideration of how the topography comes to exist, the Majority not only rejected the Patent Office's determination of product-by-process claim format, but ruled that product claims must be construed by "default" in their structural sense, without any consideration of process-like language:

> [W]ords of limitation that can connote with equal force a structural characteristic of the product or a process of manufacture are commonly and by default interpreted in their structural senses, unless the patentee has demonstrated otherwise.

App. 11a (citing *Hazani v. United States Int'l Trade Comm'n*, 126 F.3d 1473, 1479 (Fed. Cir. 1997) and *Vanguard Prods. Co. v. Parker Hannifin Corp.*, 234 F.3d 1370, 1372 (Fed. Cir. 2000)).

Circuit Judge Michel dissented. According to the Dissent, claim 1 cannot be viewed as a "pure product" claim. Rather, the claim language, as understood by both the Patent Office and the District Court, and as any reasonable competitor would understand, must be read to include a process limitation:

> I disagree with the majority's construction of claim 1 as a pure product claim. The majority's construction runs counter to the definition of claim terms chosen by the patentee as well as the analyses of the district court and the patent examiner, both of whom expressly interpreted claim 1 as a product-by-process claim. The

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(Cont'd)

Court required in its construction), the patent would not only permit any embossing method, but would not require embossing in the first place (so long as a "topography" exists)—a remarkable result for a patent entitled "Multiple Embossed Webs."

> majority incorrectly reads the definition of "multiple embossed" as purely structural, when in my view it requires process. Moreover, the majority's claim construction may weaken the notice function of this claim: I believe a reasonable competitor would read claim 1 as a product claim with a process limitation.

App. 19a.

The Dissent relied not only on the language of claim 1 and the Patent Office's conclusions, but on the definitions recited by the patentee. Specifically, the Dissent pointed out that both the definition of "embossed" and "multiple embossed" contained in the written description used verb clauses indicative of a process, which must be "recognized as meaningful." App. 21a. Taking both definitions together, the Dissent concluded that the process inherent in these terms (both incorporated as limitations in claim 1) requires "the superimposition of two or more topographies—each on a tool—onto the web." App 22a.[8] Finally, the Dissent found

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8. Even though the Dissent recognized that claim 1 calls for the superimposition of at least two different topographies—each on a tool—onto the web, the Dissent disagreed that the tools need be applied sequentially. Yet the Dissent failed to explain how two different topographies, on two separate tools, could be applied in a way that meets the remaining requirements of claim 1 (*i.e.*, the first embossed pattern be located "in" the second embossed pattern) unless the tools were applied to the web sequentially. As a practical matter, only a skilled illusionist could, using two tools with different topographies, place one embossed pattern "in" a second embossed pattern through simultaneous application of the tools. Apparently, the Dissent overlooked the requirement that the first embossed pattern be located "in" the second embossed pattern. Having found that claim 1 requires the process of embossing two or more topographies—each on a tool—onto the web, the conclusion that the embossing takes place in sequence must necessarily follow.

that Avery's EZ Film liner cannot infringe because the pattern on its liner results from only one embossing tool. App. 23a.

After finding that the term "embossed" does not describe how the web is made (and may not even mean embossed), the Majority remanded to the district court "for further proceedings not inconsistent" with the decision. Upon remand, Judge Doty inexplicably recused himself from further proceedings in this case.

REASONS FOR GRANTING THE PETITION

When this Court declared in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), that patent claim construction is to be decided as a matter of law by courts, not juries, vast improvements in patent litigation were envisioned: early certainty, reduced litigation costs, and enhanced judicial efficiency. Those results have not been achieved. To the contrary, the Federal Circuit—the final arbiter of what patent claims mean in most cases—reverses nearly one-half of all claim construction decisions presented for appellate review.[9] Because claim construction often carries dispositive results in patent litigation, this astonishingly high reversal rate has led to a breakdown in the orderly resolution of patent cases. More distressingly, the uncertainty of claim language meaning has led to the inability of law abiding corporations to accurately forecast

9. Between April 1995 and November 1997, immediately following the *Markman* decision, the claim construction reversal rate hovered around forty percent. *See Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1476 n.4 (Fed. Cir. 1998) (Rader, J., dissenting). A study of Federal Circuit cases between April 1996 and January 2001 reveals that the Federal Circuit rejects at least one of a district court's claim constructions in 33% of cases, and of those cases, the Federal Circuit reverses or remands 81% of the district court's decisions. Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases*, 12 Fed. Cir. Bar J. 1, 10-11 (2002).

and to predictably determine when a new product will and will not infringe the patent of another. The issues presented for review in this case can materially promote the fair notice requirements of the Patent Act, codified by Congress in 35 U.S.C. § 112(2), and for this reason the petition should be granted.[10]

Although *Markman* removed the construction of patent terms from the province of jury determination by declaring claim construction a question of law for the court and not a jury, *Markman* did not reach the important issue of the deference federal courts owe to factual and mixed fact and law findings by the Patent Office during the patent examination process after a patent issues. When the Patent Office declines to approve a patent application, thereby making determinations of fact and mixed fact and law concerning patentability, this Court has held that section 706 of the Administrative Procedures Act ("APA") requires a reviewing court to apply a deferential standard of review to that expert agency's conclusions. *Dickinson v. Zurko*, 527

10. The implications of the claim construction reversal rate and the corresponding lack of fair notice that the public receives of proprietary patent rights has been examined by dozens of legal scholars and commentators, who have proposed a variety of solutions. *See* Arti K. Rai, *Engaging Facts and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 Colum. L. Rev. 1035 (2003); Craig A. Nard, *A Theory of Claim Interpretation*, 14 Harv. J. Law & Tec. 2 (2000); Christian A. Chu, *Empirical Analysis of the Federal Circuit's Claim Construction Trends*, 16 Berkeley Tech. L.J. 1075 (2001); John S. Wiley, Jr., *Taming Patent: Six Steps for Surviving Scary Patent Cases*, 50 U.C.L.A. L. Rev. 1413 (2003); Gwendolyn Dawson, *Note: Matchmaking in the Realm of Patents: A Call for the Marriage of Patent Theory and Claim Construction Procedure*, 79 Tex. L. Rev. 1257 (2001); Richard C. Komson & Jessica L. Rando, *High Reversal Rate of Markman Decisions Weakens their Intended Value*, 10 Intellectual Property Strategist No. 3, at 1, (Dec. 23, 2003); Douglas Y'Barbo, *How to Fix the Federal Circuit's Standard of Review*, 5 Intellectual Property Strategist No. 9 at 7 (June 1999).

U.S. 150 (1999). This Court has not yet addressed whether the Patent Office's determinations regarding the claiming format used by an applicant, which thereby dictate the scope of the patent rights created, require a reviewing court to apply a deferential standard of review to that expert agency's conclusions.[11]

In patent claim construction appeals, the deference given to prior factual findings has not been addressed by this Court and, with respect to district court findings, has been the subject of spirited debate among the Federal Circuit Judges. *Markman* did not address the weight that the Federal Circuit should give to factual findings—whether by lower courts or administrative agencies—when performing the judicial task of construing claims. Subsequent to *Markman*, the Federal Circuit, in a sharply divided *en banc* decision, held that district court resolution of matters extrinsic to the patent claims when interpreting claim language are entitled to no deference or weight. *See Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998).[12]

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11. A determination by the Patent Office that an applicant used a particular claiming format when seeking a patent necessarily involves factual as well as mixed fact and law determinations. For example, when reviewing claims expressed as a means for performing a certain function, the Examiner must factually determine whether certain words are used and whether the remainder of the claim contains sufficient structure for achieving the specified function. Manual of Examining Procedure ("MPEP"), § 2181 (8th ed. 2003) (setting forth a three-prong factual test for determining whether a claim limitation will be interpreted to invoke 35 U.S.C. § 112, ¶ 6). Likewise, whether a claim is drafted in "product-by-process" format involves fact and mixed fact and law determinations. *See* MPEP § 2173.05(p).

12. The *Cybor* decision itself has been the subject of intense debate among not only the judges of the Federal Circuit, but lower courts and the Patent Bar as well. *See Cybor*, 138 F.3d at 1463, 1473,

(Cont'd)

The Federal Circuit's decision below takes the *Cybor* doctrine one step further: The Federal Circuit will not only ignore a district court's findings on disputed evidence in construing claims, but will give no deference to the Patent Office's determinations regarding claim format absent an affirmative statement by the applicant reflecting "clear and unmistakable acquiescence" to the Patent Office's determinations. App. 16a. Requiring a patent applicant to acquiesce to the Patent Office's determinations before a court will show deference to that expert agency's conclusions turns the Administrative Procedures Act on its head. Instead of deferring to the expert agency charged with examining patents, courts are instructed to ignore the agency and defer only to the applicants upon acquiescence to the Patent Office's conclusions.[13] In the end, when the public cannot rely on the Patent Office's determinations regarding the proprietary rights granted by the government in an issued patent, the public loses.

(Cont'd)

1478 (opinions of Judges Mayer, Newman, and Rader); *Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, 890 F. Supp. 329, 333 n.7 (D. Del. 1995) (criticizing the "no deference" rule); *Elf Atochem North Am., Inc. v. Libbey-Owens-Ford Co.*, 894 F. Supp. 844, 857 (D. Del. 1995) (same); Dunner & Kwon, *Cybor Corp. v. FAS Technologies: The Final Say on Appellate Review of Claim Construction*, 80 J.P.T.O.S. 481 (1998); Rainey & Marshall, *Cybor Trouble: Who Really Interprets a Patent Claim?* 4 Intellectual Property Strategist No. 10 at 6 (1998); Hulse, *Cybor Corp. v. FAS Technologies, Inc.*, 14 Berkeley Tech. L.J. 87 (1999).

13. Of course patent applicants and their attorneys have enough common sense to remain silent in response to the Patent Office's conclusions about claim format and scope, especially when an amendment to proposed claim language can overcome a rejection. Under the Majority's rule, applicants seldom, if ever, will "clearly and unmistakably" acquiesce in the Patent Office's conclusions because they will be free to argue for broader (or narrower) scope and differing formats during litigation by remaining silent.

Granting review to address this important issue is particularly appropriate here. Not only did the Federal Circuit's lack of deference to the Patent Office's findings regarding claim format lead to an incorrect result in a 2-1 decision, it resulted in a new rule of claim construction that, if followed, would result in even less predictability in determining the scope of patent rights. Under the new rule, terms in product claims descriptive of both process and structure—often verbs used in past tense like "embossed"—must be construed by "default" solely in their structural sense without any consideration of the inherent process. App. 11a. But where as here, process-like terms communicate no identifiable structure in addition to the structure already provided by other limitations in the claim, the process-like terms becomes superfluous unless they are given meaning in a process sense. Review should be granted to further promote fair notice in our patent system: Where applicants have chosen to draft product claims using process limitations—descriptive both of structure and the way in which the structure is achieved—those claims should not be construed in a way that reads the process limitations out of the claims.

ARGUMENT

I. This Court Should Grant Certiorari To Settle The Question Concerning The Deference Owed To Patent Office Determinations Regarding Claim Format And The Scope Of Rights Thereby Created When Courts Construe Patent Claim Terms

By design, patents do not include all the information that is relevant to the described invention, since patents speak to those skilled in the art to whom the patent is directed, not to laymen.[14] Facts known to such skilled persons that are not set forth in the intrinsic patent documents are presumed to be known by persons reading and interpreting the subject patent. Under 35 U.S.C. § 112, patent specifications must be written to enable one skilled in the art to understand the claimed invention enough to practice it without undue experimentation.[15] This rule reflects the technological complexity of patents. It would be impracticable to require

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14. *In re Nelson*, 280 F.2d 420, 425 (C.C.P.A. 1969) ("[D]escriptions in patents are not addressed to public generally, to lawyers or to judges, but as § 112 says, to those skilled in art to which the invention pertains or with which it is most nearly connected."); *In re Myers*, 410 F.2d 420, 425 (C.C.P.A. 1969) ("[T]he claims of a patent are to be construed in light of the specification and the understanding thereof by those skilled in that art to whom they are addressed."); *In re Salem*, 553 F.2d 676, 683 (C.C.P.A. 1977) (courts "must give due consideration to the interpretation that one of ordinary skill in the art would give the terminology in question").

15. *Wood v. Underhill*, 46 U.S. 1, 4 (1847) (specification had to be in such full, clear, and exact terms as to enable any one skilled in art to which it appertained to compound and use it without making any experiments of his own); *In re Johnson*, 282 F.2d 370, 372 (C.C.P.A. 1960) (reference in first paragraph of 35 U.S.C. § 112 to enable any person skilled in the art" requires that a court read and interpret specific disclosures of utility against background of knowledge possessed by such person).

applicants to teach all knowledge necessary to make a patent comprehensible to a lay person. Because the law recognizes that patents are directed toward a particular audience (those skilled in the relevant art), the patent record need only reflect what individuals within that audience would not know.[16]

Analyzing patents in the context of the relevant art begins with the Patent Office's examination of the patent application. In 1836, Congress created the Patent Office and established a system of examining patent applications for compliance with novelty over the prior art and of clear claiming so the public could understand the scope of a patentee's proprietary rights.[17] When an inventor submits a patent application, the Patent Office assigns it to an examiner with technical training in the pertinent technology as well as training in the mechanics of claim format and drafting.[18] Based on this

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16. *Avery v. Hilder*, 99 F.2d 979 (C.C.P.A. 1938) (applicant did not "need to describe and set out that which was common and well known even though it be part of the machine which he has improved"); *General Elec. Co. v. Brenner*, 407 F.2d 1258 (D.C. Cir. 1968) ("Terms need only be reasonable with respect to art involved; they need not inform laymen or disclose what the skilled already possesses.").

17. Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117.

18. *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984):

> [The Patent Office is a] qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents.

Markman v. Westview Instruments, Inc., 52 F.3d 967, 986 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) ("Patent applications, unlike contracts, are reviewed by patent examiners, quasi-judicial officials trained in the law. . . .").

technical and legal training, patent examiners are uniquely qualified to analyze claimed inventions in the context of a person skilled in the art, and to grant claims properly defining for the public the scope of exclusive rights. For this reason, reviewing courts have "generally defer[ed] to the technical expertise possessed by the Patent Office in originally issuing a patent." *National Bus. Sys. v. Am Intl., Inc.*, 743 F.2d 1227, 1232 (7th Cir., 1984).[19]

Judicial deference to Patent Office determinations is grounded not only in the unique skill that examiners possess, but in the dictates of the Administrative Procedures Act ("APA") as well. Under section 706 of the APA, reviewing courts may only set aside "agency action, findings, and conclusions found to be . . . arbitrary, capricious, and abuse of discretion, or otherwise not in accordance with law. . . ." 5 U.S.C. § 706(2)(A). This deferential standard mandates that reviewing courts respect the expertise of the agency charged with substantive administration of laws.[20]

19. *See also Chicago Rawhide Mfg. Co. v. Crane Packing Co.*, 523 F.2d 452, 458 (7th Cir. 1975), *cert. denied*, 423 U.S. 1091 (1976) ("There is an additional aspect to the presumption which relates to the deference due to the technical expertise possessed by the Patent Office and not generally possessed by federal judges"); *Parker v. Motorola, Inc.*, 524 F.2d 518, 521 (5th Cir. 1975).

20. *Good Samaritan Hospital, Corvallis v. Mathews*, 609 F.2d 949, 951 (9th Cir. 1979) ("The standard of review in 5 U.S.C. § 706 frees the reviewing court of the time consuming and difficult task of weighing evidence, gives proper respect to the expertise of the administrative tribunal and helps promote uniform application of the statute."); *Energy Consumers and Producers Ass'n v. DOE*, 632 F.2d 129, 143 (TECA 1980), *cert. denied*, 449 U.S. 832 (1980) ("In the absence of exceptional adverse circumstances this court should defer to a reasonable exercise expertise expressed in an interpretation rule by an administrative agency."); *North American Van Lines, Inc. v. Interstate Commerce Comm.*, 666 F.2d 1087, 1093 (7th Cir., 1981) ("Under this standard, a court must defer to agency expertise and may not substitute its judgment for that of the administrative agency.).

Deferential review extends to both factual findings and findings on mixed questions of fact and law.[21]

Here, the District Court did just what *Markman* and the APA demands: It examined the claims, the written description, and the file history. In examining the file history, the District Court deferred to the Patent Office's conclusion that the applicants elected to define their invention in terms of a product produced by a particular process—namely, embossing multiple patterns on a web. [A0009, 11.] Yet the Federal Circuit failed to give the slightest weight to the Patent Office's conclusions. Instead, the Federal Circuit considered only whether the applicants had "acquiesced" in the Patent Office's conclusions, without independently considering whether the Patent Office reached its conclusions in an arbitrary or capricious manner.

This lack of deference defeats the very purpose of entrusting claim construction to judges rather than juries—predictability and public certainty:

> [W]e see the importance of uniformity in the treatment of a given patent as an independent reason to allocate all issues of construction to the court. [T]he limits of a patent must be known for the protection of the patentee, the encouragement

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21. *Coca-Cola Co. v. Atchison, Topeka, and Santa Fe R.R. Co.*, 608 F.2d 213, 218 (5th Cir. 1979) ("Factual findings and findings on mixed questions of fact and law . . . are subject to a limited standard of judicial review and are set aside only if arbitrary, capricious, and abuse of discretion or otherwise not in accordance with law. . . .") (internal quotes omitted); *Puerto Rico Aqueduct & Sewer Auth. v. United States EPA*, 35 F.3d 600, 604 (1st Cir. 1994) ("[A]n agency deserves an extra measure of deference with regard to factual questions involving scientific matters in its area of expertise. . . . Mixed questions of law and fact, at least to the extent that they are fact-dominated, fall under this rubric.") (citations omitted).

> of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. Otherwise, a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field, and the public [would] be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.

Markman, 517 U.S. at 390 (internal citations and quotations omitted). When the public cannot rely on the Patent Office's statements regarding claim format and scope in the public documents made available for that very purpose, allocating claim construction to courts merely shifts the "zone of uncertainty" from one entity—juries—to another—the courts.

The only justification for not deferring to the Patent Office's conclusions is the "de novo" review standard for claim construction. *Cybor*, 138 F.3d at 1448; *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 970-71 (Fed. Cir. 1999). But "de novo" review of claim construction does not mean that the Patent Office's conclusions—particularly those expressed in the intrinsic patent documents and inherently requiring factual determinations—must be discarded. Indeed, this Court has held just the opposite for factual determinations made by the Patent Office when it rejects patent applications. In such cases, a reviewing court must defer to the Patent Office's conclusions unless they are found to be arbitrary and capricious. *Zurko*, 527 U.S. at 163-64. A contrary rule for Patent Office conclusions when it approves patents not only undermines the fair notice function of patents demanded in 35 U.S.C. § 112 and produces bad decisions, but will increase litigation, discourage settlement, and promote revisionism in defining a patent's scope. *See Cybor*, 138 F.3d at 1476 (Rader, J. dissenting).

Finally, other areas of the law support judicial deference to Patent Office determinations regarding claim format and resulting scope of patentable rights when construing claims. For example, patent claim construction has been analogized as a close cousin to statutory interpretation.[22] In reviewing an agency's statutory construction, this Court has held that administrative deference applies, and has established a two step analysis for determining the appropriate level of deference:

> When a court reviews an agency's construction of the statute which it administers, it is confronted with two questions. First, always, is the question whether Congress has directly spoken to the precise question at issue. If the intent of Congress is clear, that is the end of the matter; for the court, as well as the agency, must give effect to the unambiguously expressed intent of Congress. If, however, the court determines Congress has not directly addressed the precise question at issue, the court does not simply impose its own construction on the statute, as would be necessary in the absence of an administrative interpretation. Rather, if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.

Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 842-43 (1984) (footnotes omitted).

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22. *Digital Biometrics v. Identix, Inc.*, 149 F.3d 1335, 1344 (Fed. Cir., 1998) ("[T]he interpretation of claims, as with the interpretation of statutes and contracts, turns on the actual wording of the claim. . . ."); *Markman*, 52 F.3d at 987 ("The more appropriate analogy for interpreting patent claims is the statutory interpretation analogy.").

The Federal Circuit's failure to give the weight mandated for statutory construction to at least the Patent Office's conclusions about claim format and scope of rights thereby created in the patents it has issued deprives the public of the same rights without telling the public "what is it that limits these rights." *Markman*, 517 U.S. at 390. It also contributes to the unacceptably high reversal rate of claim construction decisions by district courts. Deference to Patent Office determinations in construing claims is important in every patent case, and the Federal Circuit has gone very wrong. This Court's review is warranted.

II. This Court Should Grant Review Because The Decision Below Conflicts With Established Precedents And Broadens Product Claims Beyond The Plain Meaning Of Language Used To Define Those Rights

The decision below holds that terms connoting both a structural characteristic and a process of manufacture must be interpreted "by default" in their "structural sense, unless the patentee has demonstrated otherwise." App. 11a. But even construed as "structural," process limitations in a product claim must be given meaning in defining the required structure. For example, under the pronounced rule, a claim calling for "welded" metal sheets arranged in a particular format, if construed as purely "structural," could cover any metal sheets, bolted or otherwise joined, so long as they were arranged in the specified format. In applying the rule below, the Majority decision reached just that conclusion: a claim for a web with two embossed patterns only requires a particular "topography" without any requirement that the web contain impressions formed from application of an embossing tool. App. 17a. Because the remainder of the claim at issue already described the topography, the Majority decision effectively read the word "embossed" out of the claim in

violation of countless decisions holding that all terms have meaning.[23]

Supporting its new rule of law, the Majority cites *Hazani v. United States Int'l Trade Comm'n*, 126 F.3d 1473, 1479 (Fed. Cir. 1997) for the proposition that the phrase "chemically engraved" was not a process term. App. 12a. But even when process terms in a product claim are interpreted as "structural," *Hazani* makes clear that neither the process-like limitation itself nor the process required to achieve the described structure can be ignored in defining that structural limitation. The *Hazani* court construed "chemically engraved" in light of the specification as "asperities . . . *produced by* oxidation." *Hazani*, 126 F.3d at 1479 (emphasis added). Then, in considering validity, the *Hazani* court found the claim anticipated because the prior art disclosed "surfaces that have asperities of the sort produced by oxidation. . . ." *Id.* Thus, the *Hazani* court considered the process of chemical engraving as well as the structure resulting from that process in both defining the structural limitation and thereafter adjudicating validity.[24] The Majority here did not.[25]

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23. *See e.g.*, *Techsearch L.L.C. v. Intel Corp.*, 286 F.3d 1360, 1373 (Fed. Cir. 2002) ("[S]pecific claim limitations cannot be ignored as insignificant or immaterial in determining infringement.").

24. When structural terms in a product claim already convey to one skilled in the art a definite structure, additional process terms, which describe no separate physical characteristics, can only be construed in the process sense. Take the example of "chemically engraved" in *Hazani*. The term "engraved" described the physical characteristics of the claimed surface. Adding the word "chemically" was not superfluous—it described an oxidizing process that produces asperities. For 3M's claimed web, structural language—a "pattern of depressions" and a "pattern of lands and ridges"—conveyed a definite structure. Adding the word "embossed" could only describe

(Cont'd)

The disparate reasoning of the Majority and Dissent opinions, along with the opinion of the District Court, demonstrates that existing law provides insufficient guidance by which competitors can divine claim coverage for product claims drafted with process and process-like limitations. For example, the Majority found that two terms in claim 1—"embossed" and "multiple embossed"—are "entirely structural" and "describe[] only [a] structural relationship." App. 11a, 17a. In contrast, both the Dissent and the District Court agreed with the Patent Office that 3M used process terms to define its invention. App. 19a, 48a. Likewise, the Dissent concludes "a reasonable competitor would read claim 1 as a product claim with process limitations." App. 19a. No court has ever expressly delineated the circumstances and factual indicia that differentiate a structural from a process limitation in a product claim. If a senior district court judge and three Federal Circuit judges cannot agree when process

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(Cont'd)
how the two patterns come into existence. Yet the Majority opinion, relying on the "default" rule of interpretation as structural (App. 11a), apparently reads the term embossed as nothing more than a "surface topography." App. 16a-17a. This adds nothing to the claim because the rest of the claim language already describes a surface "topography." Assuming that "embossed" has some meaning in the claim in addition to the other language used, Avery cannot tell what surface "topography" might fall within the meaning of "embossed" and what surface topography would not.

25. The decision in *Vanguard Prods. Co. v. Parker Hannifin Corp.*, 234 F.3d 1370, 1372 (Fed. Cir. 2000), also cited in the Majority's opinion, App. 12a, does not differ. In fact, unlike this case and *Hazani*, *Vanguard* did not involve a past tense verb or adjective limiting a noun in a product claim. Rather, the claim at issue recited two layers, and described the relationship between them as "integral therewith"—a noun phrase. Accordingly, the *Vanguard* court properly rejected an argument that "integral therewith" required a "coextrude" manufacturing process, for a "coextrude" requirement lacked any support in the claim language. *Id.*

words in product claims constitute a process and not a structural limitation, and vice versa, reasonable competitors cannot know the boundaries of patent claims using process terms in product claims. This Court should accept review and establish the circumstances under which process terms used in product claim are given meaning and how they should be construed.

CONCLUSION

The Federal Circuit's decision contravenes important principles and policies, and conflicts with established patent law precedents. A writ of certiorari should issue to review the decision below.

Respectfully submitted,

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APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DECIDED DECEMBER 2, 2003

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

No. 03-1203

3M INNOVATIVE PROPERTIES COMPANY and Minnesota Mining and Manufacturing Company,

Plaintiffs-Appellants,

v.

AVERY DENNISON CORPORATION,

Defendant-Appellee.

DECIDED: December 2, 2003

Before MICHEL, CLEVENGER and LINN, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* CLEVENGER. Dissenting opinion filed by *Circuit Judge* MICHEL.

CLEVENGER, *Circuit Judge*.

Plaintiffs-Appellants 3M Innovative Properties Company and Minnesota Mining and Manufacturing Company (collectively "3M") sued Defendant-Appellee Avery Dennison ("Avery") for infringement of claim 1 of U.S.

Appendix A

Patent No. 5,897,930 ("the '930 patent") in the United States District Court for the District of Minnesota. After construing disputed claim terms, the district court entered summary judgment in favor of Avery, concluding that Avery did not infringe, as a matter of law, the '930 patent either literally or under the doctrine of equivalents. We reverse the district court's claim construction, vacate its summary judgment and remand for further proceedings not inconsistent with this opinion.

I

3M and Avery compete in the market for adhesive-based products for the commercial graphics industry. In our increasingly image-suffused world, this industry seems to have targeted all available surfaces in public places, including the exterior of busses, trucks and other vehicles, as appropriate locations for advertising images. So that these advertisements may be efficiently and pervasively placed on such diverse surfaces, images are pre-printed onto sheets of adhesive-backed film. These films, like bumper stickers, have release liners that can be stripped off to reveal a pressure sensitive adhesive just prior to affixation of the image.

Even one of skill in the art of sticking films on surfaces can experience difficulties. Correct positioning of a large image may require repeated adjustments, and if the film is not initially placed in precisely the desired position, removing the film and repositioning it is likely to damage the film and mar the sought-after image. Additionally, pockets of air, in the form of bubbles or blisters, may become entrapped between the film and the surface if the two are not mated perfectly.

Appendix A

The '930 patent describes a release liner that, according to 3M, avoids these positioning and air-entrapment difficulties. Also according to 3M, Avery's EZ Film liner infringes the claims of the '930 patent in the features it uses to provide these benefits.

II

As implicated in the current litigation, the '930 patent "relates to embossed webs useful as liners for pressure sensitive adhesives." '930 patent, col. 1, ll. 5-7. When used as a "release liner," the "embossed web" is the adhesive-protective layer that is removed from the back of the film to expose the adhesive. More specifically, the '930 patent addresses embossed webs that are manufactured with a particular type of three-dimensional configuration or "topography" that are useful insofar as they fashion an obverse topography in the exposed adhesive.

Only independent product claim 1 of the '930 patent is at issue in this appeal, and it reads as follows:

> 1. A carrier web, comprising: at least one surface that has a *multiple embossed pattern having a first embossed pattern and a second embossed pattern,* wherein the first embossed pattern forms an array of depressions, wherein the depressions of the first embossed pattern are in the second embossed pattern, wherein the second embossed pattern comprises lands and ridges between the lands, and wherein the height of the ridges over the lands ranges from about 3 to about 45m.

(emphasis added).

Appendix A

In the preferred embodiment, the first and second embossed patterns each serves a different function. The "depressions" of the first embossed pattern in the web enhance the film's positionability. They result in protruding bumps in the exposed adhesive, minimizing the surface area of the initial points of contact between the adhesive and the substrate and increasing the ease with which the image-imprinted film can be positioned after initial contact but before complete adhesion. Additionally, if nonadhesive granules, such as glass beads, are placed in the depressions prior to the web being coated with adhesive, the granules stick to the adhesive when the liner is removed, creating nonadhesive bumps and further increasing positionability. In contrast, the "ridges" in between the "lands" of the second embossed pattern in the web result in a network of valleys in the exposed adhesive. Because these valleys create channels through which air can flow even after the film has adhered to the substrate, air that would otherwise become trapped as air bubbles due to imperfect application of the film can escape.

Independent method claim 6 is also relevant to this appeal, although 3M does not allege that Avery has infringed it. Claim 6 provides:

> A method of embossing, comprising the steps of:
>
> (a) embossing a carrier web having at least one surface with a first pattern, to create a first pattern of depressions;

Appendix A

(b) embossing the surface with a second pattern, to create a second pattern of depressions comprising lands and ridges;

wherein the depressions created from the first embossing step are substantially preserved during the second embossing step even though the second embossing step superimposes the second pattern on the depressions created by the first embossing step, and wherein the height of the ridges over the land ranges from about 3 to about 45m.

The specification provides several definitions for terms used in claim 1, two of which are relevant here:

"Embossed" means a topography on a web or on tooling having an effective three-dimensional pattern that generates a difference in surface planar dimension in the liner or the tooling.

* * *

"Multiple embossed" means two or more embossing patterns are superimposed on the web to create a complex pattern of differing depths of embossing.

'930 patent, col. 1, ll. 61-64, col. 2, ll.1-3.

Appendix A

III

Avery's accused product is its EZ Film, an adhesive-backed graphics film with both positionability and air-egress features. The EZ Film liner is created by first depositing or printing polyurethane "ink" dots (the "PU dots") on top of the liner's outer polyethylene layer (the "PE layer") and then embossing a pattern of hexagonal ridges and lands in the liner when the PU/PE combination passes over an embossing roll. This hexagonal pattern in the liner creates air-egress-enabling channels in the adhesive layer when the liner is removed. At some point (or points) in the manufacturing process, the PU dots are pressed into the PE layer of the liner.[1] When the liner is removed from the adhesive layer, the PU dots remain affixed to the adhesive, creating less-adhesive, positionability-enhancing bumps.

IV

3M alleges that the Avery EZ Film liner infringes the '930 patent because the dents in the PE layer of the liner

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1. Avery alleges that, during the manufacture of its EZ Film liner, the PU dots are imbedded only at the embossing roll, the same point in the process at which the hexagonal pattern is created. The district court noted that "3M present[ed] expert testimony to support its contention that embossing occurs at the squeegee roll," a point in the process earlier than the embossing roll, but it concluded that "that testimony does not create a genuine issue of material fact." *See 3M Innovative Props. Co. v. Avery Dennison Corp.*, No. Civ.01-1781 (DSD/FLN), 2002 WL 31628395, at *5 n. 5 (D.Minn. Oct.19, 2002). Because we reverse the district court's claim construction, we need not review the district court's conclusion that no genuine issue of material fact existed.

(created when the PU dots are embedded) constitute a "first embossed pattern," the hexagonal pattern constitutes a "second embossed pattern," and because all remaining claim limIn its first order, the district court construed claim 1 of the '930 patent and denied 3M's plea for a preliminary injunction on the ground, among other things, that 3M had not demonstrated a likelihood of success on the merits of its infringement claim. *See 3M Innovative Props. Co. v. Avery Dennison Corp.*, 185 F.Supp.2d 1031, 1037-41 (D.Minn.2002) ("*3M I*"). In a second order ruling on Avery's motion for summary judgment of noninfringement, the district court adopted the claim construction from *3M I, see 3M Innovative Props. Co. v. Avery Dennison Corp.*, No. Civ.01-1781 (DSD/FLN), 2002 WL 31628395, at *3 & n. 2 (D.Minn. Oct.19, 2002) ("*3M II*"), and granted Avery's motion, *id.* at *7.

In *3M I*, the district court construed two terms from claim 1. First, construing the term "multiple embossed pattern," the district court held that "[w]hile the language of the claim does not mention the word 'sequential,' it nevertheless illustrates that the term 'multiple embossed pattern' requires sequential embossments." 185 F.Supp.2d at 1038. To arrive at this conclusion, the district court relied on its view of the plain meaning of "first" and "second" and characterized the definition of "multiple embossed" in the specification as evidence of the claim's product-by-process nature. *Id.* at 1038-39. Second, the court relied on the specification's express definition of the term "embossed," as well as a source that the district court treated as a technical dictionary,[2]

2. "The TAPPI 1993-1994 Technical Information Sheets define 'embossing' as 'creating a finish or design imparted by compressing (Cont'd)

to construe it to mean "a topography created on material by impressing a corresponding inverse topography on its surface." *Id.* at 1040-41.

In *3M II*, the district court concluded that the Avery EZ Film liner did not, as a matter of law, literally infringe claim 1 because the accused product was manufactured using an "embedding" process and the product resulting from such an embedding process was not "embossed" as per the definition given to that term during claim construction. *3M II,* 2002 WL 31628395, at *4. Moreover, the PU dots printed onto the liner were softened during the embedding process, so the PE layer of the liner was "not the inverse topography of the hardened PU ink dot earlier flexographically printed on the liner." *Id.* at *5. The district court also concluded that the Avery EZ Film liner did not, as a matter of law, infringe under the doctrine of equivalents because "[t]he doctrine of equivalents cannot be employed in a manner that vitiates a claim limitation," *id.* at *6 (citing *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys.*, 242 F.3d 1337, 1347 (Fed.Cir.2001); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1367 (Fed.Cir.1999)), and Avery had removed "one of the steps of the '930 patent—the 'first embossed pattern' forming an array of depressions," *id.*

(Cont'd)

a material between matched rigid surfaces or rigid and ductile surface having the desired raised or depressed surface pattern.'" *3M I,* 185 F.Supp.2d at 1041.

Appendix A

V

In entering a summary judgment of noninfringement, the district court resolved both steps of the infringement inquiry as a matter of law; on appeal, we therefore review both de novo: (1) the scope of the patent claims and (2) the lack of a genuine issue of material fact in the conclusion that the device does not contain all of the limitations, either literally or by equivalents, that are present in the claims. *See Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 970-71, 974 (Fed.Cir.1999). In a case such as this one, however, where the district court's claim construction is reversed and a new one is given, we frequently remand for the district court to reconsider the components of the second step—namely, whether a genuine issue of material fact exists and whether either party is entitled to summary judgment—using the new claim construction. *See, e.g., Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1338 (Fed.Cir.2001).

Claim construction begins with the language of the claims. *See Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed.Cir.1999). In construing patent claims, there is "a 'heavy presumption' that a claim term carries its ordinary and customary meaning," *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed.Cir.2002) (quoting *Johnson Worldwide Assocs.*, 175 F.3d at 989), namely its meaning "amongst artisans of ordinary skill in the relevant art at the time of the invention," *ResQNet.com, Inc. v. Lansa, Inc.*, 347 F.3d 1374, 1378 (Fed.Cir.2003) (citing *Rexnord*, 274 F.3d at 1342). "[D]ictionaries and treatises may also assist the courts." *Id.* (citing *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed.Cir.2002));

see also Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 n. 6 (Fed.Cir.1996) (noting that "[j]udges . . . may . . . rely on dictionary definitions" to construe claim terms).

A term's ordinary meaning, however, must be considered in the context of all intrinsic evidence, namely the claims, the specification, and the prosecution history. *See Rexnord,* 274 F.3d at 1342-43 (explaining that claim terms must be examined in light of the specification and the prosecution history); *cf. Gart v. Logitech, Inc.*, 254 F.3d 1334, 1339-40 (Fed.Cir.2001) (defining intrinsic evidence). While limitations in the specification must not be routinely imported into the claims because a patentee need not describe all embodiments of his invention, *see Rexnord,* 274 F.3d at 1344, a definition of a claim term in the specification will prevail over a term's ordinary meaning if the patentee has acted as his own lexicographer and clearly set forth a different definition, *see Tex. Digital Sys.*, 308 F.3d at 1204 (noting that "the inconsistent dictionary definition must be rejected" if the specification rebuts the presumption of ordinary and customary meaning); *Rexnord,* 274 F.3d at 1342. "This court also considers the prosecution history . . . to determine whether the applicant clearly and unambiguously 'disclaimed or disavowed [any interpretation] during prosecution in order to obtain claim allowance.' " *Middleton, Inc. v. Minn. Mining & Mfg. Co.*, 311 F.3d 1384, 1388 (Fed.Cir.2002) (quoting *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed.Cir.1985)) (alteration in original); *see also Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed.Cir.2003) (noting that "the doctrine of prosecution disclaimer" does not apply "where the alleged disavowal of claim scope is ambiguous").

Appendix A

A

The district court erred when it defined the term "multiple embossed patterns" to include a limitation that the patterns be created sequentially. The use of the terms "first" and "second" is a common patent-law convention to distinguish between repeated instances of an element or limitation. *See, e.g., Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1304 (Fed.Cir.2003) (first and second sidewall surfaces); *Springs Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 992 (Fed.Cir.2003) (first and second opposed ends). In the context of claim 1, the use of the terms "first . . . pattern" and "second . . . pattern" is equivalent to a reference to "pattern A" and "pattern B," and should not in and of itself impose a serial or temporal limitation onto claim 1.

In the specification, 3M clearly acted as its own lexicographer, and the definition provided requires only that the "two or more embossing patterns" be "superimposed." '930 patent, col. 2, ll. 1-2. Despite Avery's arguments to the contrary, the use of "superimposed" in this definition neither transforms claim 1 into a product-by-process claim nor even limits the scope of the claim to a serial method of manufacture; it describes only the structural relationship between the embossing patterns. *See Webster's Third New International Dictionary* 2294 (1993) (defining "superimposed" as "layered"). Furthermore, even words of limitation that can connote with equal force a structural characteristic of the product or a process of manufacture are commonly and by default interpreted in their structural sense, unless the patentee has demonstrated otherwise. *See Hanzai*

v. United States Int'l Trade Comm'n, 126 F.3d 1473, 1479 (Fed.Cir.1997) (concluding that "chemically engraved" was not a process term); *Vanguard Prods. Co. v. Parker Hannifin Corp.*, 234 F.3d 1370, 1372 (Fed.Cir.2000) (holding that the claim term "integral" describes a structural relation, not the particular manufacturing process related in the specification); *cf. id.* ("A novel product that meets the criteria of patentability is not limited to the process by which it was made." (citing 3 Donald S. Chisum, *Chisum on Patents* § 8.05, at 8-79 (2000))).

Nothing in the intrinsic evidence of the patent requires that a limitation of sequential creation of the "multiple embossed pattern" should be included in claim 1. The limitation of serial embossing clearly present in method claim 6 cannot be read into claim 1; furthermore, method claim 6 creates new terms—"the first embossing *step* " and "the second embossing *step* "—to carry the serial-embossing limitation. It is true that language in the specification of the '930 patent recurrently recites serial application of the two patterns. *See, e.g.*, '930 patent, col. 3, ll. 16-17 ("An advantage of the present invention is to create a means of sequential manufacturing of articles using different depths of depressions and same or different materials."); *id.*, col. 6, ll. 66-67 ("Because the multiple embossings of the web occur sequentially. . . ."). Limitations from the specification, however, cannot be imported into the claims, and this rule must be strictly enforced in light of the clear definition of "multiple embossed" provided in the specification—a definition devoid of sequential limitation. Furthermore, the specification also discloses the option, albeit not the preferred option, of creating multiple embossed patterns in a single

step. *See id.*, col. 2, ll. 11-15 ("Although the multiple embossing steps could be combined into a single step with the design of a suitable tool or mold, the advantage of multiple steps is that the depressions formed by the prior step(s) can be filled with material prior to the subsequent embossing step(s).").

A broadening claim amendment made during the prosecution history of the '930 patent supports a plain-meaning construction of claim 1 without a sequential-embossment limitation. As filed in the original patent application, claim 1 was expressly limited to a "multiple sequentially embossed" web.[3] In response to the examiner's § 112, ¶ 2 indefiniteness rejection, 3M amended claim 1 to claim a carrier web "that has a multiple embossed pattern having a first embossed pattern and a second embossed pattern," referring to definitions of "multiple embossed" and "embossed" that were in the specification at the time of the original patent application. The fact that 3M broadened its claims in response to an indefiniteness rejection and dropped the sequential limitation is perhaps unusual, but it is entirely permissible, and the plain language of the claim as issued must control. *Cf. Smith v. Snow,* 294 U.S. 1, 16 (1935) ("It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed

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3. As initially filed, claim 1 read: "A carrier web, comprising: at least one surface that is multiple, sequentially embossed with a pattern, wherein depressions created from the prior embossing pattern(s) are substantially preserved during the subsequent embossing pattern(s) even though the subsequent embossing pattern(s) are superimposed on the depressions from the prior embossing patterns(s)."

by the allowance of the broader claim 1."); *United States v. Telectronics, Inc.*, 857 F.2d 778, 782-83 (Fed.Cir.1988) (concluding that adding a limitation to a claim during prosecution and then removing it when the limitation failed to result in allowance of the claim over the prior art does not permit reading of limitation into claim when the claim issued without it).

Avery also argues that claim 1 contains a sequential-embossment limitation because of the arguments that 3M made during prosecution to overcome section 102(b) anticipation and section 103(a) obviousness rejections by the examiner. To traverse an anticipation rejection of both product claim 1 and method claim 8 (which eventually issued as method claim 6) based on references that taught that "two or more adhesives having different properties may be coated into the same recesses" on the web, 3M stated that:

> Applicants here are claiming two different embossed patterns where the first embossed pattern survives the embossing of the second pattern. See Fig. 2, for an illustration of this patentable point. In [the prior art reference], there is only one embossed pattern, that can be filled with the same or different adhesives. There are not two embossed patterns as Applicants require in Claims 1 and 8.

The examiner withdrew his objection in response to 3M's argument.[4]

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4. 3M made similar arguments to traverse another anticipation and an obviousness rejection as well.

Avery argues that 3M thus expressly disclaimed any patent scope beyond sequential embossment of patterns when it used language pregnant with temporal implications—the first pattern "survives" the embossing of the second—to traverse the examiner's rejections. 3M's use of the term "survives" in the prosecution history, however, does not constitute the clear and unambiguous disavowal of claim scope that is required to read a limitation into an expressly defined term. *See Middleton,* 311 F.3d at 1388. To distinguish the prior art in question, 3M needed only to argue, as it did in the last two sentences of the quotation above, that the '930 patent claimed "two embossed patterns" rather than "one embossed pattern." When the patentee has expressly defined a term in the specification and remarks made to distinguish claims from the prior art are broader than necessary to distinguish the prior art, the full breadth of the remark is not a clear and unambiguous disavowal of claim scope as required to depart from the meaning of the term provided in the written description. *Storage Tech. Corp. v. Cisco Sys., Inc.,* 329 F.3d 823, 833 (Fed.Cir.2003). Furthermore, Figure 2 of the '930 patent, to which 3M directed the examiner, illustrates only the coexistence of two distinct patterns in the final product, not the sequential embossing of the patterns.

Finally, in explaining a subsequent anticipation rejection under section 102(b) on the basis of other prior art, the examiner stated that claim 1 was "drafted in the product-by-process format." 3M never responded to this statement during the remainder of the prosecution because the objection was overcome without any need to address whether claim 1 was or was not a product-by-process claim. In this context, the

examiner's statement does not constitute a clear and unmistakable surrender of claim scope. *See Middleton,* 311 F.3d at 1388. [P]rosecution history . . . cannot be used to limit the scope of a claim unless the *applicant* took a position before the PTO. *Schwing GmbH v. Putzmeister Aktiengesellschaft,* 305 F.3d 1318, 1324-25 (Fed.Cir.2002) (emphasis added). An applicant's silence in response to an examiner's characterization of a claim does not reflect the applicant's clear and unmistakable acquiescence to that characterization if the claim is eventually allowed on grounds unrelated to the examiner's unrebutted characterization.

B

The district court also erred when it defined the term "embossed" by imposing a limitation related to the process by which the embossed surface is made. *See 3M I,* 185 F.Supp.2d at 1040-41 (defining embossed as "a topography created on material by impressing a corresponding inverse topography on its surface"). Because 3M expressly acted as its own lexicographer by providing a definition of embossed in the specification, the definition in the specification controls the meaning of embossed, regardless of any potential conflict with the term's ordinary meaning as reflected in technical dictionaries. *See Tex. Digital Sys.,* 308 F.3d at 1204; *Rexnord,* 274 F.3d at 1342.

The specification expressly states that "'[e]mbossed' means a topography on a web or on tooling having an effective three-dimensional pattern that generates a difference in surface planar dimension in the liner or the tooling." '930 patent, col. 1, ll. 61-64. This definition defines

"embossed" materials to include both the web and the tooling (a device that can be used to impress a pattern into a web), provided each has a "topography" that has "an effective three-dimensional pattern that generates a difference in surface planar dimension."[5] This definition is entirely structural. 3M defines an "embossed" material as one that has particular surface characteristics: a "topography" with an "effective three-dimensional pattern," the pattern creating "a difference in surface planar dimension."

The district court erred when it introduced a process limitation of embossed by requiring the topography to be created by *impression* of a corresponding inverse topography. The patent does not limit *how* the embossed pattern, as defined in the specification, is created.

VI

Because the district court erred in its claim construction, the reasoning underpinning its grant of summary judgment

5. If the district court's definition were correct, then the definition provided in the specification (which of course cannot be ignored) would create a problem of infinite recursion: the tooling itself would have to be created "by impressing a corresponding inverse topography on [the tooling's] surface"; the "corresponding inverse topography" that creates the tooling, itself a meta-tooling, would have to be created "by impressing a corresponding inverse topography on [the meta-tooling's] surface," etc. At oral argument, Avery argued that the definition in the specification must be ignored because it is nonsensical. *Cf. CCS Fitness,* 288 F.3d at 1367 (noting that a claim term will not be given its ordinary meaning if the term deprives the claim of all clarity). The only interpretation under which the definition of embossed provided in the specification is nonsensical is Avery's.

of noninfringement to Avery is no longer relevant. We do not reach the question of infringement under its now-vacated claim construction. Furthermore, because the parties have not briefed infringement under our claim construction, and because we cannot determine whether sufficient discovery has occurred to rule on infringement-related summary judgment motions using this court's claim construction, we remand to the district court for further proceedings not inconsistent with this opinion.

COSTS

No costs.

REVERSED-IN-PART, VACATED-IN-PART AND REMANDED.

Appendix A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

No. 03-1203

3M INNOVATIVE PROPERTIES COMPANY and Minnesota Mining and Manufacturing Company,

Plaintiffs-Appellants,

v.

AVERY DENNISON CORPORATION,

Defendant-Appellee.

MICHEL, Circuit Judge, dissenting.

I respectfully dissent, because I disagree with the majority's construction of claim 1 as a pure product claim. The majority's construction runs counter to the definition of claim terms chosen by the patentee as well as the analyses of the district court and the patent examiner, both of whom expressly interpreted claim 1 as a product-by-process claim. The majority incorrectly reads the definition of "multiple embossed" as purely structural, when in my view it requires process. Moreover, the majority's claim construction may weaken the notice function of this claim: I believe a reasonable competitor would read claim 1 as a product claim with a process limitation.

Appendix A

Claim 1 reads as follows:

> 1. A carrier web, comprising: at least one surface that has a ***multiple embossed pattern*** having a first embossed pattern and a second embossed pattern, wherein the first embossed pattern forms an array of depressions, wherein the depressions of the first embossed pattern are in the second embossed pattern, wherein the second embossed pattern comprises lands and ridges between the lands, and wherein the height of the ridges over the lands ranges from about 3 to about 45 μm.

'930 patent, col. 9, ll. 32-41 (emphasis added). Defendant argues that the use of the claim term "multiple embossed pattern" requires that the carrier web have undergone embossing, in much the same way that a claim term "welded joint" would mean a joint that results from the process of welding. (Red Br. at 28.) Defendant further contends that the required embossing must be sequential, *i.e.*, multiple embossing tools sequentially emboss different patterns onto the carrier web. Although the district court accepted both of these arguments, the majority now rejects both.

The written description states:

> "Embossed" means a topography on a web or on tooling having an effective three-dimensional pattern that generates a difference in surface planar dimension in the liner or the tooling.
>
> . . .

Appendix A

> "Multiple embossed" means two or more embossing patterns are superimposed on the web to create a complex pattern of differing depths of embossing.

'930 patent, col. 1, ll. 61-64, col. 2, ll. 1-3. The majority interprets the definition of "multiple embossed" as "neither transform[ing] claim 1 into a product-by-process claim nor even limit[ing] the scope of the claim to a serial method of manufacture; it describes only the structural relationship between the embossing patterns." (Maj. Op. at 1371.) The majority interprets the definition of "embossed" to be "entirely structural." (*Id.* at 1374.) Based on its interpretations of the two definitions—and its correct conclusion that the patentee nowhere clearly disavowed these definitions—the majority construes claim 1 as purely structural.

I do not think the definition of "multiple embossed" describes only the structural relationship between the embossing patterns. To the contrary, the definition expressly requires that an action have taken place: "'[m]ultiple embossed' means *two or more embossing patterns are superimposed on the web to create* a complex pattern of differing depths of embossing." '930 patent, col. 2, ll. 1-3 (emphasis added). The highlighted text is a verb clause—"*are superimposed . . . to create*"—and its inclusion in the definition must be recognized as meaningful.

Having concluded that the definition of "multiple embossed" requires process, the next issue is what is the meaning of the definitional language "two or more embossing patterns are superimposed on the web to create. . . ." Here, I

turn to the written description's definition of "embossed": "a topography *on a web or on tooling* having an effective three-dimensional pattern that generates a difference in surface planar dimension in the liner or the tooling." '930 patent, col. 1, ll. 61-64 (emphasis added). Applying this definition, I conclude that the "two or more embossing patterns superimposed on the web" result from two or more topographies, each on a web or on tooling. In the context of embossing of a liner, the relevant topographies initially are only on tooling—that is, the liner is embossed by tools. Thus, I interpret the process in the definition of "multiple embossed" as the superimposition of two or more topographies—each on a tool—onto the web. This process is incorporated as a limitation into claim 1 through the claim's use of the term "multiple embossed."

Unlike the district court, however, I do not view claim 1's process limitation as necessarily sequential. Nothing in the definition of "multiple embossed" compels the conclusion that the tools are applied to the web serially, as opposed to simultaneously. Moreover, I agree with the majority that the prosecution history and the remainder of the written description do not contain a clear disavowal of a simultaneous application of the embossing tools. Indeed, although a sequential process is repeatedly discussed, one sentence of the written description clearly contemplates a simultaneous process. '930 patent, col. 2, ll. 11-12 ("Although the multiple embossing steps could be combined into a single step . . ."). I therefore do not construe the term "multiple embossed" in claim 1 as requiring the sequential application of embossing tools.

Nevertheless, because the accused product's pattern results from only one embossing tool, it is not "multiple embossed." As it therefore cannot infringe, I would affirm the summary judgment of non-infringement, even though several of the district court's constructions—including the sequential requirement—were incorrect. The judgment may stand regardless of these errors, because under the correct claim construction infringement by defendant's product cannot be shown.

APPENDIX B — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MINNESOTA DATED OCTOBER 19, 2002

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA
Civil No. 01-1781(DSD/FLN)

3M INNOVATIVE PROPERTIES COMPANY and Minnesota Mining and Manufacturing Company,

Plaintiffs,

v.

AVERY DENNISON CORPORATION,

Defendant.

Carolyn V. Peters, Esq., 3M Company, P.O. Box 33427, St. Paul, MN 55133; Frank P. Porcelli, Esq., Kurt L. Glitzenstein, Esq. and Fish & Richardson, Suite 3100, 225 Franklin Street, Boston, MA 02110; John C. Adkisson, Esq., R.J. Zayed, Esq. and Fish & Richardson, 3300 Dain Bosworth Plaza, 60 South Sixth Street, Minneapolis, MN 55402, counsel for plaintiffs.

David P. Pearson, Esq. and Winthrop & Weinstine, 3200 Minnesota World Trade Center, 30 East Seventh Street, St. Paul, MN 55101; Jay R. Campbell, Esq. and Renner, Otto, Boisselle & Sklar, 1621 Euclid Avenue, Cleveland, OH 44114; Roderick G. Dorman, Esq., Lawrence M. Hadley, Esq. and Hennigan, Bennett & Dorman, 601 Figueroa Street South, Suite 3300, Los Angeles, CA 90017, counsel for defendant.

Appendix B

ORDER

This matter is before the court upon defendant Avery-Dennison Corporation's motion for summary judgment. Based upon a review of the file, record and proceedings herein, and for the reasons stated, the court grants that motion.

BACKGROUND

This action involves the alleged infringement of a patent relating to advanced commercial adhesive products. Plaintiff 3M Innovative Properties Company ("3M") produces, develops and markets adhesive-based products for the commercial graphics industry. Defendant Avery-Dennison Corporation ("Avery") is a leading competitor in this market. 3M asserts that Avery's "EZ Series Fleet Marketing Films" ("EZ Films") infringe upon 3M's Comply product, specifically United States Patent No. 5,897,930 (the " '930 patent").

Commercial graphic materials are used for advertising, logos and signs on the exterior of trucks, buses and other large vehicles. Instead of traditionally painting the advertisements onto the vehicles, computer generated logos and murals are created and generated onto a layer of film. Similar to a bumper sticker, the film has a "release liner" that when stripped off exposes a pressure-sensitive adhesive. The large sheet of film is then placed onto the vehicle, essentially "wrapping" the vehicle in the adhesive graphic. The task of "wrapping" a vehicle with the film is one that poses two problems: (1) positionability and (2) air entrapment.

Appendix B

A. Positionability

The problem of positionability occurs when the film is not correctly situated initially. There is a risk that the product will wrinkle, tear, or stretch when it is repositioned. In 1993, 3M addressed this problem with its Controltac products. Conventionally, the surfaces on both the release liner and the adhesive film are smooth. Controltac products, on the other hand, have a shaped release liner that imparts a special contour to the surface of the adhesive. The surface of the Controltac adhesive is covered with bumps or protrusions that are made of glass beads and a small amount of adhesive. These bumps, naked to the human eye, are only a few microns high.[1]

Because these bumps project out from the surface of the aggressive adhesive, they are the first to come into contact with the application surface. Instead of immediately adhering to the surface, because of the glass beads, the adhesive film can be slid over the surface until it is in the desired location. Once in place, the installer simply presses firmly down on the adhesive film, allowing the aggressive adhesive surrounding the beads to come into contact with the surface to form a permanent bond.

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1. The bumps on the adhesive surface are created with a special release liner that has micron-scale depressions. Each depression in the release liner will form one of the bumps on the adhesive film. By spreading the mixture of both glass and adhesive across the release liner, molds of glass beads are formed. A screen of aggressive adhesive is then layered over these beads. In the final step of the application process, when the release liner is peeled off, the glass bumps remain stuck to the adhesive layer.

Appendix B

B. Air Entrapment

Installers of large scale commercial graphics also face the problem of air entrapment. When air becomes trapped beneath the film, the graphic's appearance may become blemished by blisters or bubbles. To address this issue, 3M modified the adhesive surface by adding micron-scale channels to the release liner to allow air to "bleed" out of the edges of the adhesive film. The surface area of the release liner above the depressions are called "lands." A high spot on the release liner creates a low spot on the adhesive film. The release liner is disclosed and claimed in the '930 patent.

C. 3M's Patent

3M marketed products with these two features, glass beads to better position the film and air channels to combat air entrapment, as "Controltac Plus Graphic Films with Comply Performance Adhesive Technology" ("the Comply products"). 3M received a patent for the technology included in the Comply products, patent '930. The language of claim 1 of 3M's '930 patent, a relevant claim in this action, states:

> A carrier web, comprising:
>
> at least one surface that has a multiple embossed pattern having a first embossed pattern and a second embossed pattern, wherein the first embossed pattern forms an array of depressions, wherein the depressions of the first embossed pattern in the second embossed pattern, wherein the second embossed pattern comprises lands and

> ridges between the lands, and wherein the height of the ridges over the lands ranges from about 3 to 45 microns.

Claim 6, also relevant to this dispute, requires a first embossed pattern of depressions.

D. EZ Films

3M asserts that Avery's EZ Films infringe upon the '930 patent. Specifically relevant to this motion, 3M contends that Avery's EZ Films contain a "multiple embossed pattern" with a "first embossed pattern" creating an array of "depressions."

To make its EZ Films, Avery deposits raised liquid PU ink dots on the surface of a liner in a process know as flexographic printing. (McHugh Decl. at ¶ 17.) The raised ink dots are hardened on the liner through a UV curing process. The liner then goes through the embossing process. The printed liner first passes over a number of guide rolls and heating elements prior to reaching the embossing roll. 3M explains that Avery's liner then is embossed twice, first prior to the embossing roll at the squeegee roll and then at the embossing roll. (*See, e.g.*, Pl.'s Mem. in Resp. to Def.'s Mot. for Summ. J. at 8, 14-15.) Avery, however, alleges that the liner is embossed only once and describes the embossing process as follows:

> At the contact area or "nip" formed between the bed roll and the embossing roll, two events occur simultaneously: the inverse of the hexagonal pattern on the embossing roll is impressed into

> and then removed from the PE layer of the liner (thus "embossing" the liner with a hexagonal pattern), and the softened PU ink material is pressed into the softened liner and displaces the PE material in the liner, forming a composite polymer liner material with a flush surface.

(Def.'s Mem. in. Supp. of Mot. Summ. J. at 7.) The parties also dispute whether Avery's EZ Films contain "depressions," as required by the '930 patent.

Because Avery claims that it does not infringe upon the '930 patent, Avery now brings a motion for summary judgment. Based upon a review of the file, record and proceedings herein, and for the reasons stated, the court grants defendant's motion for summary judgment.

DISCUSSION

I. Standard for Summary Judgment

Rule 56(c) of the Federal Rules of Civil Procedure provides that summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." In order for the moving party to prevail, it must demonstrate to the court that "there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." *Celotex Corp. v. Catrett,* 477 U.S. 317, 322 (1986) (quoting Fed.R.Civ.P. 56(c)). A fact is

material only when its resolution affects the outcome of the case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute is genuine if the evidence is such that it could cause a reasonable jury to return a verdict for either party. *See id.* at 252.

On a motion for summary judgment, all evidence and inferences are to be viewed in a light most favorable to the nonmoving party. *See id.* at 255. The nonmoving party, however, may not rest upon mere denials or allegations in the pleadings, but must set forth specific facts sufficient to raise a genuine issue for trial. *See Celotex*, 477 U.S. at 324. Moreover, if a plaintiff cannot support each essential element of its claim, summary judgment must be granted because a complete failure of proof regarding an essential element necessarily renders all other facts immaterial. *Id.* at 322-23.

II. Infringement Analysis

An infringement analysis requires two steps. The first is to construe the meaning and the scope of the patent claims, a step commonly referred to as claim construction. *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1575 (Fed.Cir.1995). The second is to determine whether the accused invention infringes the patent claim as construed. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed.Cir.1995). A product infringes a patent if it contains every limitation of any one claim or an equivalent of each limitation not literally met. *Dolly, Inc. v. Spaulding & Evenflo Cos., Inc.*, 16 F.3d 394, 397 (Fed.Cir.1994); *Becton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 796 (Fed.Cir.1990). While the first step is solely a question of law to be

determined by the court, the second step is one for the trier of fact. *Purdue Pharma L.P. v. Boehringer Ingelheim GMBH*, 237 F.3d 1359, 1363 (Fed.Cir.2001); *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55 (Fed.Cir.1998) (en banc).

After the claims are construed as a matter of law, the court must consider whether "a reasonable trier of fact could find that every limitation in any construed claim at issue" may be found in the accused device. *Unidynamics Corp. v. Automatic Prods. Int'l, Ltd.*, 157 F.3d 1311, 1316-17 (Fed.Cir.1998). While the determination of whether an accused device infringes a claim literally or under the doctrine of equivalents is normally a question of fact, *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 1379 (Fed.Cir.2000), a district court may grant summary judgment "when it is shown that the infringement issue can be reasonably decided only in favor of the movant, when all reasonable factual inferences are drawn in favor of the non-movant." *Voice Tech. Group Inc. v. VMC Sys., Inc.*, 164 F.3d 605, 612 (Fed.Cir.1999); *see also Optical Disc Corp. v. Del Mar Avionics*, 208 F.3d 1324, 1335-36 (Fed.Cir.2000) ("Summary Judgment of noninfringement under the doctrine of equivalents is proper if no reasonable jury could determine that a claim limitation is met in the accused device by an equivalent."). Because the court previously construed the relevant disputed claim terms,[2] the court now must compare the claims as construed to the allegedly infringing device.

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2. In *3M Innovative Properties Co. v. Avery Dennison Corp.*, 185 F.Supp.2d 1031 (D.Minn.2002), the court engaged in the first step of an infringement analysis by construing the relevant disputed claim terms in its preliminary injunction order.

Appendix B

A. Infringement of the '930 Patent

The court finds that Avery's EZ Films do not infringe upon 3M's '930 patent literally or under the doctrine of equivalents because they do not have a "multiple embossed pattern" with a "first embossing step" as required under claims 1 and 6.[3]

1. No literal infringement.

In its preliminary injunction order, the court defined the term "multiple embossed pattern" to mean "sequential embossing patterns" and the term "embossed" to mean "a topography created on material by impressing a corresponding inverse topography on its surface."[4] *3M Innovative Properties Co.*, 185 F.Supp.2d 1031, 1040 (D.Minn.2002). Based upon those definitions, Avery argues that its liner does not literally infringe upon the '930 patent because, in part, its liner does not contain a "multiple embossed pattern" or a "first embossing step." 3M, however, argues that Avery pre-imbeds ink dots, which constitutes a first embossed pattern and thus that its liner contains a "multiple embossed pattern." After careful review, the court

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3. While Avery also claims that its EZ Films do not infringe upon the '930 patent because they do not have a first embossed pattern of "depressions," the court does not address that argument because the court finds that Avery's EZ Films do not have a "multiple embossed pattern."

4. Avery requests that the court clarify its earlier claim construction by amending the court's construction of the term "emboss." The court finds that such a clarification is unnecessary.

finds that, even assuming pre-imbedding occurs, which the parties dispute, pre-imbedded ink dots do not constitute a first embossed pattern under the court's definition of "embossed." Thus, Avery's EZ Films do not contain a "multiple embossed pattern" or a "first embossing step" because there are no sequential embossing steps.

a. Embedding is not embossing.

Ink dots pre-embedded in a liner do not constitute a "first embossed pattern" because embedding is not embossing. (McHugh Decl. at ¶ 20.) As persons skilled in the art recognize, embedding is "[the] complete encasement or encapsulation, creating a composite structure," while embossing is "the use of an embossing roll or tool to impress a corresponding, inverse topography in a material." (*Id.*) Technical dictionaries do not equate the two terms. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 n.6 (Fed.Cir.1996) ("Judges are free to . . . rely on dictionary definitions when construing claim terms . . ."). For instance, the Encyclopedia of Polymer Science and Technology describes embedding as often synonymous with "casting . . . , potting, molding, impregnation, and encapsulation." (McHugh Decl., Ex. 2 at 792-93.) It does not equate embedding with embossing. (*Id.*; *see also* McHugh Decl., Ex. 2 at 620.)

Nontechnical dictionaries also distinguish between embedding and embossing. *See* Merriam-Webster's Collegiate Dictionary at 376-77 (10th ed.1998) (defining "emboss" as "to raise the surface of into bosses . . . ; to raise in relief from a surface . . ." and defining "embed" as "to

enclose closely in . . ."); The American Heritage Dictionary at 447-48 (2d College ed.1985) (defining "emboss" as "[t]o mold or carve in relief . . . ; raise the surface of in relief" and defining "embed" as "to fix firmly in a surrounding mass . . . To enclose in a matrix . . . To enclose snugly or firmly . . . To make an integral part of."). Thus, because pre-embedding is not embossing, pre-embedded ink dots do not create a first embossing step.

b. No Evidence of embossed inverse topography

Moreover, contrary to 3M's assertion, the Avery's liner does not undergo a first embossment at the squeegee stage or at the embossing nip, (McHugh Decl. at ¶ 22), when the ink dot is allegedly pre-imbedded, because an imbedded ink dot does not create an embossed inverse topography on a liner's surface. Instead, an embedded ink dot displaces a portion of the PE liner material, forming a composite PE/PU liner material with a flush surface.[5] (McHugh Decl. at ¶ 16.) The molten PE liner material encasing the softened, embedded PU ink dot is not the inverse topography of the hardened PU ink dot earlier flexographically printed on the liner. (McHugh Decl. at ¶¶ 17-18.) Therefore, the ink dot does not act as an embossing tool by creating an inverse embossed pattern and thus Avery's liner does not literally infringe upon the '930 patent because it does not have a "multiple embossed pattern" with a "first embossing step."

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5. While 3M presents expert testimony to support its contention that embossing occurs at the squeegee roll, (Strong Decl., Ex. 1), that testimony does not create a genuine issue of material fact.

Appendix B

2. No infringement under doctrine of equivalents

Further, Avery's EZ Films do not infringe upon the '930 Patent under the doctrine of equivalents. Under that doctrine, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997). The doctrine applies objectively to the individual elements of a claim, not to the invention as a whole. *Id.* at 21. Consequently, a claim is infringed only if each limitation in the claim is found in the accused devise, either literally or by a substantial equivalent. *Wooster Brush Co. v. Newell Operating Co.*, 46 F.Supp.2d 713, 721 (N.D.Ohio 1999).

The key question in evaluating patent infringement under the doctrine of equivalents is "whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element." *Warner-Jenkinson Co.*, 520 U.S. at 40; *see also Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831, 1838 (2002) ("The doctrine of equivalents allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes."); *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed.Cir.1991) ("infringement may be found if an accused device performs substantially the same function in substantially the same way to achieve substantially the same result."). One way to determine if

substantial differences exist is to apply the "function-way-result" test. Under that test, the fact-finder considers whether the disputed element of the accused device performs substantially the same function in substantially the same way to achieve substantially the same result as the limitation at issue in the patent. *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1315 (Fed.Cir.1998); *Wooster Brush Co.*, 46 F.Supp.2d at 721.

The Supreme Court and Federal Circuit have cautioned against a broad application of the doctrine of equivalents. *Warner-Jenkinson Co.*, 520 U.S. at 29 (emphasizing that "the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement"); *London*, 946 F.2d at 1538; *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1367 (Fed.Cir.1999); *Ethicon Endo-Surgery*, 149 F.3d at 1316. The doctrine of equivalents cannot be employed in a manner that vitiates a claim limitation. *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys.*, 242 F.3d 1337, 1347 (Fed.Cir.2001); *K-2 Corp.*, 191 F.3d at 1367.

In *Wooster Brush*, the Northern District of Ohio granted summary judgment of non-infringement, finding that an accused device using only a single application of a bonding material did not meet the equivalents test where the patent called for two distinct, sequential applications of the bonding material. *Wooster Brush*, 46 F.Supp.2d at 722. Because the court's comprehensive analysis is directly on point, it is set out in full:

> Plaintiff Wooster's process for producing paint rollers is accomplished in one step. Defendant

> Newell argues that Wooster's one-step process effectively collapses the '242 patent's two-step process and is therefore not significantly different from the '242 process. . . .
>
> [T]he '242 process as construed by this Court contains separate elements which produce the final product. . . . Under the terms of the patent claims, this process must occur in sequence.
>
> In the New Wooster process, the formation of the core and the adhesion of the cover to the core occur simultaneously, facilitated by one application of liquid thermoplastic material. Wooster's one-step process is not a combination of the '242 patent's elements; it does not represent a more efficient way of applying two strips of liquid thermoplastic material. Rather, it represents a new method by which one of the two steps of the '242 patent—the second application of the adhesive material and relevant cooling period—is eliminated. To interpret Wooster's process as equivalent to the '242 patent's elements would thus fly in the face of the Supreme Court's admonition that equivalence does not exist when a finding of equivalence would eliminate an element in the patented process.

Id. at 721.

Similar to the accused device in *Wooster Brush*, Avery's printed and single embossed liner is not a combination of

the '930 patent elements. Rather, it represents a new method by which one of the steps of the '930 patent—the "first embossed pattern" forming an array of depressions—is removed. It is a process that produces positionability and air egress without the claimed, sequential, multiple embossed pattern. Because the doctrine of equivalents cannot be used to vitiate a claim limitation, the doctrine of equivalents cannot be used to bring Avery's EZ Films within the scope of the '930 patent claims. Thus, the court grants Avery's motion for summary judgment because Avery's EZ Films do not infringe upon the '930 patent either literally or under the doctrine of equivalents.[6]

CONCLUSION

Accordingly, **IT IS HEREBY ORDERED** that defendant's motion for summary judgment is granted.

Dated: October 19, 2002

s/ David S. Doty
David S. Doty, Judge
United States District Judge

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6. Both independent claims 1 and 6 of the '930 patent require a first embossed pattern of depressions. Because these claims are not infringed, none of the dependent claims can be infringed. *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 1553 (Fed.Cir.1989) ("It is axiomatic that dependent claims cannot be found infringed unless the claims from which they depend have been found to have been infringed.").

APPENDIX C — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MINNESOTA DATED FEBRUARY 15, 2002

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA
Civil No. 01-1781(DSD/FLN)

3M INNOVATIVE PROPERTIES COMPANY and Minnesota Mining and Manufacturing Company,

Plaintiffs,

v.

AVERY DENNISON CORPORATION,

Defendant.

Carolyn V. Peters, Esq., 3M Company, P.O. Box 33427, St. Paul, MN 55133; Frank P. Porcelli, Esq., Kurt L. Glitzenstein, Esq. and Fish & Richardson, Suite 3100, 225 Franklin Street, Boston, MA 02110; John C. Adkisson, Esq., R.J. Zayed, Esq. and Fish & Richardson, 3300 Dain Bosworth Plaza, 60 South Sixth Street, Minneapolis, MN 55402, counsel for plaintiffs.

David P. Pearson, Esq. and Winthrop & Weinstine, 3200 Minnesota World Trade Center, 30 East Seventh Street, St. Paul, MN 55101; Jay R. Campbell, Esq. and Renner, Otto, Boisselle & Sklar, 1621 Euclid Avenue, Cleveland, OH 44114; Roderick G. Dorman, Esq., Lawrence M. Hadley, Esq. and Hennigan, Bennett & Dorman, 601 Figueroa Street South, Suite 3300, Los Angeles, CA 90017, counsel for defendant.

Appendix C

ORDER

This matter is before the court upon plaintiff's motion for a preliminary injunction, defendant's motion to submit the supplemental declaration of Anthony McHugh, and plaintiff's motion for leave to submit the supplemental declaration of Charles A. Calisto. Based on a review of the file, record and proceedings herein, and for the reasons stated, the court denies plaintiff's motion for a preliminary injunction, grants defendant's motion to submit the supplemental declaration of Anthony McHugh, and grants plaintiff's motion for leave to submit the supplemental declaration of Charles A. Calisto.

BACKGROUND

This action involves the alleged infringement of a patent relating to advanced commercial adhesive products. Plaintiff 3M Innovative Properties Company ("3M") produces, develops and markets adhesive-based products for the commercial graphics industry. Defendant Avery-Dennison Corporation ("Avery") is a leading competitor in this market. 3M asserts that Avery's "EZ Series Fleet Marketing Films" infringes upon 3M's Comply product, specifically United States Patent No. 5,897,930 (the " '930 patent").

Commercial graphic materials are used for advertising, logos and signs on the exterior of trucks, buses and other large vehicles. Instead of traditionally painting the advertisements onto the vehicles, computer generated logos and murals are created and generated onto a layer of film. Similar to a bumper sticker, the film has a "release liner"

that when stripped off exposes a pressure-sensitive adhesive. The large sheet of film is then placed onto the vehicle, essentially "wrapping" the vehicle in the adhesive graphic. The task of "wrapping" a vehicle with the film is one that poses two problems: (1) positionability and (2) air entrapment.

A. Positionability

The problem of positionability occurs when the film is not correctly situated initially. There is a risk that the product will wrinkle, tear, or stretch when it is repositioned. In 1993, 3M addressed this problem with its Controltac products. Conventionally, the surfaces on both the release liner and the adhesive film are smooth. Controltac products, on the other hand, have a shaped release liner that imparts a special contour to the surface of the adhesive. The surface of the Controltac adhesive is covered with bumps or protrusions that are made of glass beads and a small amount of adhesive. These bumps, naked to the human eye, are only a few microns high.[1]

Because these bumps project out from the surface of the aggressive adhesive, they are the first to come into contact

1. The bumps on the adhesive surface are created with a special release liner that has micron-scale depressions. Each depression in the release liner will form one of the bumps on the adhesive film. By spreading the mixture of both glass and adhesive across the release liner, molds of glass beads are formed. A screen of aggressive adhesive is then layered over these beads. In the final step of the application process, when the release liner is peeled off, the glass bumps remain stuck to the adhesive layer.

with the application surface. Instead of immediately adhering to the surface, because of the glass beads, the adhesive film can be slid over the surface until it is in the desired location. Once in place, the installer simply presses firmly down on the adhesive film, allowing the aggressive adhesive surrounding the beads to come into contact with the surface to form a permanent bond.

B. Air Entrapment

Installers of large scale commercial graphics also face the problem of air entrapment. When air becomes trapped beneath the film, the graphic's appearance may become blemished by blisters or bubbles. To address this issue, 3M modified the adhesive surface by adding micron-scale channels to the release liner to allow air to "bleed" out of the edges of the adhesive film. The surface area of the release liner above the depressions are called "lands." A high spot on the release liner creates a low spot on the adhesive film. The release liner is disclosed and claimed in the '930 patent.

C. 3M's Patent

3M marketed products with these two features, glass beads to better position the film and air channels to combat air entrapment, as "Controltac Plus Graphic Films with Comply Performance Adhesive Technology" (the Comply products). 3M received a patent for the technology included in the Comply products, patent '930. The language of

claim 1 of 3M's '930 patent, the relevant claim in this action, states:

> A carrier web, comprising:
>
> at least one surface that has a multiple embossed pattern having a first embossed pattern and a second embossed pattern, wherein the first embossed pattern forms an array of depressions, wherein the depressions of the first embossed pattern in the second embossed pattern, wherein the second embossed pattern comprises lands and ridges between the lands, and wherein the height of the ridges over the lands ranges from about 3 to 45 microns.

D. EZ Films

A leading competitor in commercial graphics, Avery developed a product which targets the same market as 3M's Comply product. 3M asserts that Avery's recently launched "EZ Series Fleet Marketing Films" ("EZ Films") infringe upon the '930 patent.

Avery's primary product in the commercial graphics market has been its FT1000 product. This product was in direct competition with 3M's Comply products. In 1998, Avery began developing a graphics film that addressed the problem of air entrapment that it faced with the FT1000 product. As a result of this effort, Avery created and launched EZ Films. EZ Films have a special release liner that has a honeycomb pattern of micron-scale ridges surrounding

hexagonal lands. The ridges and lands create the air channels in the adhesive sheet. Additionally, the liner also has micron-scale depressions that correspond to the bumps on the surface of the adhesive strip. These bumps are created by depositing raised liquid ink dots on the liner and then hardening the dots through a UV curing process. In July 2001, Avery began selling its EZ Films to buyers in the commercial graphics market.

3M argues that the release liner on Avery's EZ Films product infringes upon claim 1 of the '930 patent. 3M now seeks to enjoin Avery from making and selling its EZ Series Fleet Marking Films ("EZ Films"). 3M moves for a preliminary injunction. Based upon a review of the file, record and proceedings herein, and for the reasons stated, the court denies plaintiff's motion.[2]

DISCUSSION

I. Plaintiff's Motion for a Preliminary Injunction

The grant or denial of a preliminary injunction is within the discretion of the district court. *Amazon.com. Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1350 (Fed.Cir. 2001). As the moving party, 3M is entitled to a preliminary injunction if it can succeed in showing: (1) a reasonable likelihood of success on the merits, (2) irreparable harm if an injunction is not granted, (3) a balance of hardships tipping

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2. The court also grants Avery's motion to submit the supplemental declaration of Anthony McHugh and plaintiff's motion for leave to submit the supplemental declaration of Charles A. Calisto.

in its favor and (4) the injunction's favorable impact on the public interest. *See, e.g., id.; Purdue Pharma L.P. v. Boehringer Ingelheim GmbH,* 237 F.3d 1359, 1363 (Fed.Cir. 2001). None of these factors is dispositive. *Amazon.com. Inc. v. Barnesandnoble.com, Inc.,* 239 F.3d at 1350. Rather, the court weighs each factor against the others and against the form and magnitude of the relief sought. *Id.* (quoting *Hybritech, Inc. v. Abbott Labs.,* 849 F.2d 1446, 1451 (Fed.Cir.1988)). The Federal Circuit, however, has emphasized that "a preliminary injunction is a drastic and extraordinary remedy that is not to be routinely granted." *Intel Corp. v. ULSI Sys. Tech., Inc.,* 995 F.2d 1566, 1568 (Fed.Cir.1993). Here, the court denies plaintiff's motion for a preliminary injunction because plaintiff cannot establish a likelihood of success on the merits or irreparable harm. *See Amazon.com, Inc.,* 239 F.3d at 1350 ("a movant cannot be granted a preliminary injunction unless it establishes both of the first two factors, i.e., a likelihood of success on the merits and irreparable harm."); *Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc.,* 141 F.3d 1084, 1088 (Fed.Cir.1998) ("[Movant] had to establish both of the first of the first two factors, i.e., likelihood of success and irreparable harm, to receive a preliminary injunction.").

A. Likelihood of Success on the Merits

To establish the likelihood of success on the merits, plaintiff must show that, in light of the presumptions and burdens that will inhere at a trial on the merits, (1) plaintiff will likely prove that defendant infringes upon its patent and (2) plaintiff's infringement claim will likely withstand defendant's challenges to the validity and the enforceability of the patent. *Vehicular Tech. Corp.,* 141 F.3d at 1088.

Appendix C

1. Infringement

A product infringes on a patent if it contains every limitation of any one claim or an equivalent of each limitation not literally met. *Dolly, Inc. v. Spalding & Evenflo Cos., Inc.*, 16 F.3d 394, 397 (Fed.Cir.1994); *Becton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 796 (Fed.Cir.1990). An infringement analysis requires two steps. The first is to construe the meaning and the scope of the patent claims, a step commonly referred to as claim construction. *Southwall Tech. Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1575 (Fed.Cir.1995). The second is to determine whether the accused invention infringes the patent claim as construed. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed.Cir.1995). While the first step is solely a question of law to be determined by the court, the second step is one for the trier of fact. *Purdue*, 237 F.3d at 1363; *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55 (Fed.Cir.1998) (en banc)

a. Claim Construction of the '930 Patent

Plaintiff contends that defendant is infringing upon claim 1 of the '930 patent. Claim 1 of the '930 Patent provides:

> A web carrier, comprising:
>
> at least one surface that has a multiple embossed pattern having a first embossed pattern and a second embossed pattern, wherein the first embossed pattern forms an array of depressions, wherein the depressions of the first embossed

> pattern in the second embossed pattern, wherein the second embossed pattern comprises lands and ridges between the lands, and wherein the height of the ridges over the lands ranges from about 3 to 45 μm.

(Decl. of Adkisson, Ex. A, Col. 9, Ln. 31-42.) The parties dispute two critical terms in claim 1: "multiple embossed pattern" and "first embossed pattern . . . of depressions." Defendant contends that these terms describe a product-by-process patent requiring sequentially-created patterns with tools having corresponding topographies (Def.'s Opp. to 3M's Mot. for a Prelim. Inj. at 12), while plaintiff asserts that these terms describe the structure of the patent, not its process (P's Reply Mem. in Supp. of Mot. for Prelim. Inj. at 3-4). Those two terms therefore require construction.[3]

Claim construction involves ascertaining the true meaning and scope of each claim as a matter of law.

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3. A "true" product claim is one in which the product is defined by structural characteristics only. Chisum, Chisum on Patents, § 8.05 (Matthew Bender 1999). Such a claim is infringed by a product falling within the language of the claim, even though the infringing product is made by a process substantially different than that employed by the patentee. *Id.; see, e.g., Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co.*, 259 F. 258, 261 (6th Cir.1919) ("Certain it is, in view of the weight of authority and the latest decisions, that the inventor of a new and useful product or article of manufacture may have a patent which covers it and gives a monopoly upon it regardless of great variations in the method of making..."). A "product-by-process" claim is one in which the product is defined at least in part by describing the method or process by which it is made. Chisum, Chisum on Patents, § 8.05.

See Markman v. Westview Instruments, Inc., 517 U.S. 370, 386 (1996). In determining the meaning of the terms of a claim, the court considers "intrinsic" evidence, which consists of the language of the claims, the specification of the patent and the prosecution history. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). If the meaning of the claim terms is not ambiguous and can be determined from the intrinsic evidence, the court need not rely on extrinsic evidence in rendering its claim construction. *See id.* at 1583. Courts should give the words of a claim their ordinary and accustomed meaning, unless it appears that the inventor used them differently. *See ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1579 (Fed.Cir.1988). Here, intrinsic evidence illustrates that the terms "multiple embossed pattern" and "first embossed pattern . . . of depressions" describe a product-by-process patent requiring sequential embossments.

(1) "Multiple Embossed Pattern"

As discussed, there is a hierarchy to the evidence to be considered in claim construction: the claim language first, then the patent specification and finally the file history. *Vitronics Inc.*, 90 F.3d at 1582-85. In this case, the language of the claim, the patent specification and the file history clearly show that the term "multiple embossed pattern" defines a product-by-process patent requiring sequential embossing patterns.

While the language of the claim does not mention the word "sequential," it nevertheless illustrates that the term "multiple embossed pattern" requires sequential

embossments. In particular, the claim provides for "[a] web carrier, comprising:

> at least one surface that has a multiple embossed pattern having a first embossed pattern and a second embossed pattern. . . ."

(Adkisson Decl., Ex. A, Col. 9, lns. 33-36.) The fact that the language of claim 1 expressly refers to two separately-created embossed patterns as "a **first** embossed pattern" and a "**second** embossed pattern" clearly establishes from the language of the claim alone that the term "multiple embossed pattern" requires multiple embossments which are applied one after the other. (*Id.* (emphasis added).)

Moreover, even if the claim's language is ambiguous, which it is not, the patent specification makes absolutely clear that the term "multiple embossed pattern" mean sequential embossments. As the court in *Vitronics* stated, and as plaintiff cites, the patent specification is "[u]sually . . . dispositive; it is the single best guide to the meaning of a disputed claim." *Vitronics,* 90 F.3d at 1582; (P's Reply Mem. in Supp. of Mot. for Prelim. Inj. at 2.); *see also, United States v. Adams,* 383 U.S. 39, 49 (1966) ("[w]hile the claims . . . limit the invention, and the specifications cannot be utilized to expand the patent monopoly, . . . claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention."); *Autogiro Co. v. United States,* 181 Ct.Cl. 55, 384 F.2d 391, 397-398 (1967) ("the specification aids in ascertaining the scope and meaning of the language employed in the claims inasmuch as words must be used in the same way in both the claims and the

specification. . . . The use of the specification as a concordance for the claim is accepted by almost every court, and is a basic concept of patent law.").

The specification defines the term "multiple embossed:"

> "Multiple embossed" means two or more embossing patterns that are superimposed on the web to create a complex pattern of differing depths of embossing.

(Adkisson Decl., Ex. A, Col. 2, ln. 1-3.) Not only does that definition on its face describe a product-by-process patent, the definition specifically requires two or more embossing patterns. Moreover, that term read in the context of the rest of the specification is consistent with the understanding that "multiple embossed pattern" describes a product-by-process requiring sequential steps. In fact, the language of the sentence in the specification immediately following the definition of the term "multiple embossed pattern" provides: "Another aspect of the present invention is a carrier web having at least one surface that is multiple, **sequentially** embossed, wherein depressions created from the prior embossing pattern(s) are substantially preserved during the **subsequent** embossing pattern(s) . . ." *Id.* (emphasis added). Other language in the specification further emphasizes that the term "multiple embossed pattern" in claim 1 means sequential embossing steps:

- "Although the multiple embossing steps could be combined into a single step with the design of a suitable tool or mold, the advantage of

multiple steps is that the depressions formed by the prior step(s) can be filled with a material prior to the **subsequent** embossing step(s). The number of same or different materials can be as many as the number of sequential step(s) or can be any subset of them." (Adkisson Decl., Ex. A., Col. 2, lns. 11-17 (emphasis added)).

- "An advantage of the present invention is to create a means of **sequential** manufacturing of articles using different depths of depressions of the same or different materials." (Adkisson Decl., Ex. A, Col. 3, lns. 16-18 (emphasis added)).

- "A **sequential** manufacturing process for the web 10 or liner 20 determines the order of the embossings. The manufacturing of the double embossed liner 20 actually requires the formation of the smaller embossing pattern 26 first, followed by the formation of the larger embossing pattern 24, second." (Adkisson Decl., Ex. A, Col. 5, lns. 5-9.(emphasis added)).

- "Because the embossing of the pattern 26 occurs before the embossing of pattern 24, the depths identified here are the cumulative effects of **both embossings**, not necessarily the height of the embossing tool." (Adkisson Decl., Ex. A, Col. 6, lns. 16-24.(emphasis added)).

- "A multiple embossed web of the present invention can be used for the formation of materials that utilize the complex topography of the surface of the web. **Because the multiple embossings of** the web occur sequentially, material can be placed in the depressions caused by first pattern being formed before the second embossing pattern is applied." (Adkisson Decl., Ex. A, Col. 6, ln. 64-Col. 7, ln. 2.(emphasis added)).

The prosecution history further illustrates this understanding. Plaintiff argues that because it took the word "sequential" out of claim 1, the court would commit an error of law pursuant to the theory of file wrapper estoppel to read "sequential" back into the claim. Plaintiff's argument is unpersuasive, given the context of the prosecution history. The examiner rejected the original claim 1, finding the claim confusing. (Adkisson Decl., Ex. A, No. 4. at p. 3.) In response, plaintiff filed claim 1 as "a multiple embossed pattern having a first embossed pattern and a second embossed pattern. . . ." In contrast to plaintiff's assertion, the file history makes absolutely clear that plaintiff's patent requires a second embossed pattern following a first embossed pattern. The court therefore rejects plaintiff's file wrapper estoppel argument and finds that the term "multiple embossed pattern" means sequential embossing patterns.[4]

---

4. The court is well aware of the cannon of claim construction providing that the court cannot import a limitation from the specification's general discussion. *See, e.g., Transmatic, Inc. v. Gulton Indus., Inc.*, 53 F.3d 1270, 1278 (Fed.Cir.1995) (finding the (Cont'd)

Appendix C

(2) "First Embossed Pattern ... of Depressions"

The parties also dispute the meaning of the term "first embossed pattern . . . of depressions." While defendant claims that the first embossed pattern consists of depressions in the liner surface and that its ink deposits are embedded rather than embossed into the liner surface (Def.'s Opp. to 3M's Mot. for a Prelim. Inj. at 14), plaintiff fails to define this term. Instead, plaintiff states that "the point is that Avery subsequently presses these 'ink deposits' into the deformable release liner, and from that point on, the liner has a 'first embossed pattern of . . . depressions.'" (P's Reply Mem. in Supp. of Mot. for Prelim. Inj. at 2.) Here, the specification of the '930 Patent expressly defines "embossed:"

> "Embossed" means a topography on a web or on tooling having an effective three-dimensional

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(Cont'd)

district court "erred by importing unnecessary functional limitations into the claim."). The court, however, does not import a limitation from the specification into the claim but instead reads the term "multiple embossed pattern" in light of the specification's language, including the language about sequential embossing patterns, to interpret the term "multiple embossed pattern." *See Young Dental Mfg. Co. v. Q3 Special Prods., Inc.*, 112 F.3d 1137, 1143 (Fed.Cir.1997) ("Although limitations may not be read into the claims from the specification, claims are to be read in view of the specification of which they are a part."); *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 93 F.3d at 1578 ("the district court did not import an additional limitation into the claim; instead, it looked to the specification to aid its interpretation of a term already in the claim, an entirely appropriate practice.").

> pattern that generates a difference in surface planar dimension in the liner or the tooling.

(Adkisson Decl., Ex. A., Col. 1, In. 60-64.) Based upon this definition in the specification, the court concludes that the meaning of the term "embossed" is a topography created on material by impressing a corresponding inverse topography on its surface.

While the court need not look to extrinsic evidence to construe the term "embossed," technical dictionaries support this understanding of the term. *See Bell Atlantic v. Covad Communs. Group, Inc.*, 262 F.3d 1258, 1267 (Fed.Cir.2001) (providing that courts may rely upon scientific dictionaries). The TAPPI 1993-1994 Technical Information Sheets define "embossing" as "creating a finish or design imparted by compressing a material between matched rigid surfaces or rigid and ductile surface having the desired raised or depressed surface pattern." (Hadley Decl., Ex. 6.) Moreover, as defendant argues, plaintiff's own witness agrees with that definition of embossing:

> Q. So embossing means creating a series of impressions which are the inverse of a pattern on the embossing tool?
>
> A. That's the way I would define it.

(Hadley Decl., Ex. 7, Calisto Dep. at p. 101.)

b. Infringement

After the claims are construed as a matter of law, the court must consider whether "a reasonable trier of fact could find that every limitation in any construed claim at issue" may be found in the accused devise. *Unidynamics Corp. v. Automatic Products Int'l, Ltd.*, 157 F.3d 1311, 1316-17 (Fed.Cir.1998).

(1) Literal Infringement

Literal infringement of a claim occurs when every limitation recited in the claim appears in the accused device, or put differently, when "the properly construed claim reads on the accused device exactly." *DeMarini Sports Inc. v. Worth, Inc.*, 239 F.3d 1314, 1331 (Fed.Cir.2001) (quoting *Amhil Enters. Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1562 (Fed.Cir.1996)); *Dolly, Inc.*, 16 F.3d at 397 (an accused device must include every claim limitation of the claim). If just one limitation is missing or is not met as claimed, there is no literal infringement. *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1539 (Fed.Cir.1991); *Mas-Hamilton Group v. La Gard, Inc.*, 156 F.3d 1206, 1211 (Fed.Cir.1998).

Here, the court finds that there is no literal infringement because defendant's liner does not have a "multiple embossed pattern having a first embossed pattern and a second embossed pattern."[5] Instead, defendant deposits ink dots onto

5. The court need not address whether defendant's liner contains a "first embossed pattern . . . of depressions" because defendant's liner does not contain "multiple embossed patterns" and thus no infringement exists.

the surface of a liner in a process know as "flexographic printing." Those ink dots are hardened on the liner through UV curing. Defendant then uses a single embossing roller. The liner with the ink dots passes through that *single* embossing roller only *once.* The single roller, which has a hexagonal pattern on its roller surface, simultaneously embosses the hexagonal pattern into the liner and embeds the ink dots into the liner. Because defendant's liner contains no multiple embossed pattern with a second embossed pattern following a first embossed pattern, the court concludes that plaintiff's infringement claim fails.[6]

B. Irreparable Harm

The movant for a preliminary injunction must demonstrate not only a reasonable likelihood of success on the merits, but also a lack of adequate remedy at law or other irreparable harm. *H.H. Robertson Co. v. United Steel Deck Inc.,* 820 F.2d 384, 390 (Fed.Cir.1987). Irreparable injuries are those that are impossible to measure in monetary terms. *Atlas Powder Co. v. Ireco Chem.,* 773 F.2d 1230, 1233 (Fed.Cir.1985). A presumption of irreparable harm exists "when a clear showing has been made of patent validity and infringement." *H.H. Robertson Co.,* 820 F.2d at 390. Absent this clear showing, the patentee must submit evidence and reasoned analysis to support the argument that money damages will be an inadequate remedy. *Nutrition 21,* 930 F.2d at 872.

---

6. Because plaintiff does not claim infringement under the doctrine of equivalents, the court does not address this issue.

Here, 3M does not have a presumption of irreparable harm because it did not make a strong showing of patent infringement. *See Eli Lilly and Co.*, 82 F.3d at 1578 (finding that movant is not entitled to presumption of irreparable harm because movant "has not made a strong showing on the issue of infringement."). Since 3M did not meet its burden, 3M must provide an independent showing of irreparable harm in order to be entitled to a preliminary injunction. *Roper Corp. v. Litton Sys., Inc.*, 757 F.2d 1266, 1271 (Fed.Cir.1985). The court addresses each of 3M's claims of irreparable harm in turn and concludes that 3M cannot establish irreparable harm.

1. Loss of Reputation, Good Will and Market Share

3M argues that it will suffer irreparable harm to its reputation, good will and market share if Avery's EZ Film is allowed to remain on the market until trial. Loss of sales, profits, and market share does not constitute irreparable harm, absent special circumstances. *Eli Lilly and Co. v. American Cyanamid Co.*, 896 F.Supp. 851, 860 (S.D.Ind.1995). Potential sales loss alone during pretrial litigation cannot establish "manifest irreparable harm." Such a position would require a finding of irreparable harm to every patentee, regardless of the circumstances. *Illinois Tool Works v. Grip-Pak Inc.*, 906 F.2d 679, 683 (Fed.Cir.1990). Moreover, the court is not persuaded by 3M's argument that its reputation and goodwill will be damaged as 3M provides only speculative evidence in the record to support this claim. *See Tech Wear, Inc. v. Acme Laundry Prods., Inc.*, 38 F.Supp.2d 1147, 1152 (C.D.Cal.1998) (stating that allegations

regarding lost market share and diminished reputation, without supporting facts, are insufficient to establish irreparable harm); *Quickie Mfg. Corp. v. Libman Co.*, 180 F.Supp.2d 636 (D.N.J. 2002).

3M also asserts that the potential injury will be difficult to calculate. "Neither the difficulty in calculating losses in market share, nor speculation that such losses might occur, amount to proof of special circumstances justifying the extraordinary relief of an injunction prior to trial." *Nutrition 21,* 930 F.2d at 871. Furthermore, the practical reality of the commercial graphics market is that if 3M were to bid for a particular project during the course of the action and Avery won, the loss by 3M would be easily ascertainable and compensable in monetary terms.

3M also argues that it will have fewer dollars to invest in the research and development of its products if it is forced to continue to compete with Avery throughout the litigation. This argument is not compelling. It is difficult to imagine any manufacturer with a research and development program that could not make the same claim and thus be equally entitled to preliminary relief. *Eli Lilly,* 82 F.3d at 1578.

2. Permanent Discounts

3M claims that it will be forced to permanently lower its prices unless a preliminary injunction is immediately granted. Because this kind of harm can be measured by monetary damages, it does not constitute irreparable injury.

3. Ability to Pay Monetary Damages

The court has found that an alleged infringer's ability to pay money damages for infringement during litigation is strong evidence against a finding of irreparable harm. *Eli Lilly,* 896 F.Supp. at 860; *Nutrition 21,* 930 F.2d at 871. There is no basis for concluding that Avery will be unable to satisfy an adverse judgment. In the record before the court, there is the undisputed declaration of one of Avery's executives attesting to the company's financial soundness and ability to satisfy a monetary damage award. (Karavolos Decl. at ¶ 11.) 3M has not presented the court with clear evidence that Avery is unable to meet possible future financial obligations. In sum, the record before the court fails to support 3M's claim of irreparable injury or the inadequacy of monetary damages.

C. Balance of Hardships

Plaintiff's weak showing of likelihood of success on the merits clearly tips the balance of hardships in defendant's favor. Moreover, granting a preliminary injunction may damage defendant's reputation, causing irreparable harm, which may keep defendant's product out of the market permanently. *See Alliance Research Corp. v. Telular Corp.,* 859 F.Supp. 400, 405 (C.D.Cal.1994) ("The hardship on a preliminarily enjoined manufacturer who must withdraw its product from the market before trial can be devastating.") (quoting *Illinois Tool Works,* 906 F.2d at 683).

Conversely, plaintiff will suffer less harm if the court denies its motion for a preliminary injunction than defendant

will suffer if the court grants its motion. In light of the relatively smaller hardship plaintiff will suffer if the court denies plaintiff's motion, the court concludes that the balance of hardships titles in defendant's favor.

D. Public Policy

Finally, public policy favors denying the preliminary injunction. Public interest favors patent rights and competitive markets. *Illinois Tool Works,* 906, F.2d at 684. Allowing defendant to continue to sell its product encourages competitive markets. It does so without sacrificing plaintiff's patent rights because, as the court has noted, plaintiff has failed to show the likelihood of success on the merits. Public policy therefore favors denying plaintiff's motion for a preliminary injunction. Thus, based on an analysis of all four preliminary injunction factors, the court denies plaintiff's motion for a preliminary injunction.

Appendix C

CONCLUSION

For the foregoing reasons, **IT IS HEREBY ORDERED** that:

1. Plaintiff's motion for a preliminary injunction [Docket No. 19] is denied;

2. Defendant's motion to submit the supplemental declaration of Anthony McHugh [Docket No. 41] is granted; and

3. Plaintiff's motion for leave to submit the supplemental declaration of Charles A. Calisto [Docket No. 46] is granted.

Dated: February 15, 2002

s/ David S. Doty
David S. Doty, Judge
United States District Court

APPENDIX D — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING FILED JANUARY 20, 2004

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

(DCT – 01-CV-1781)

03-1203

3M V AVERY DENNISON

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the APPELLEE, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on January 27, 2004.

Appendix D

Circuit Judge SCHALL did not participate in the vote.

FOR THE COURT,

s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: January 20, 2004

cc: Frank P. Porcelli
Roderick G. Dorman

APPENDIX E — RELEVANT STATUTES

UNITED STATES CODE ANNOTATED
TITLE 35. PATENTS
PART II – PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

CHAPTER 11 – APPLICATION FOR PATENT

35 U.S.C.A. § 112. – Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Appendix E

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

PART III – PATENTS AND PROTECTION OF PATENT RIGHTS

CHAPTER 28 – INFRINGEMENT OF PATENTS

35 U.S.C. § 271(a). – Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

Appendix E

UNITED STATES CODE ANNOTATED
TITLE 5. GOVERNMENT ORGANIZATION AND EMPLOYEES
PART I – THE AGENCIES GENERALLY

CHAPTER 7 – JUDICIAL REVIEW

5 U.S.C. § 706. – Scope of review

To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall –

(1) compel agency action unlawfully withheld or unreasonably delayed; and

(2) hold unlawful and set aside agency action, findings, and conclusions found to be –

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(B) contrary to constitutional right, power; privilege, or immunity;

(C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;

(D) without observance of procedure required by law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or

(F) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court.

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

(2)

Supreme Court, U.S.
FILED
MAY 2 1 2004
OFFICE OF THE CLERK

No. 03-1461

IN THE

Supreme Court of the United States

AVERY DENNISON CORPORATION,

Petitioner,

v.

3M INNOVATIVE PROPERTIES COMPANY and MINNESOTA MINING & MANUFACTURING COMPANY,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals For the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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COUNTER-STATEMENT OF THE QUESTIONS PRESENTED

1. Whether the U.S. Court of Appeals for the Federal Circuit, in construing the claims of 3M's patent, properly considered a passing statement by the patent examiner, which was not an "action, finding or conclusion" of the Patent Office, and which by law could have no relevance to the patentability of the claims, in determining the meaning of claim terms explicitly defined by 3M in its patent.

2. Whether the Federal Circuit properly determined that the terms "embossed" and "multiple embossed pattern" in 3M's patent claims referred to the topography of the claimed product, and did not require that the product be made by a particular process, where:

(a) under the Federal Circuit's long precedent, the claim language did not require a particular process;

(b) the patent's specification explicitly defined the relevant term in a purely structural manner;

(c) the patent's specification provided no basis by which a limitation not in the patent claims should have been imported into the claims;

(d) the disputed claim contained process limitations when the patent application was filed, and the patent applicants removed those limitations while prosecuting the application to the Patent Office; and

(e) the examiner comment, central to Petitioner's entire petition, was entirely unrelated to the reason the examiner allowed the claims to issue.

CORPORATE DISCLOSURE STATEMENT

Respondent 3M Innovative Properties Company is a wholly owned subsidiary of respondent Minnesota Mining and Manufacturing Company (now known as 3M Company). 3M Company has no parent company, and no publicly held company owns 10% or more of its stock.

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U.S. Patent 5,897,930 2

STATUTORY PROVISIONS INVOLVED

The appeal involves 35 U.S.C. § 112, which notes that the claims of a patent (and not other portions of the patent urged by Petitioner) define the scope of a patented invention, and § 271(a), which defines patent infringement. Ultimately, this appeal involves only patent claim construction, which is indirectly related to both provisions.

The appeal does not involve 5 U.S.C. § 706, which Petitioner has never before cited. This is not an appeal from an agency action, and there was no "agency action" here.

COUNTER-STATEMENT OF THE CASE

A. Introduction

No compelling reason exists to grant this petition. The case does not present a conflict among circuits, and the Federal Circuit has shown no internal disagreement on the questions Petitioner presents. (The dissent below was premised on other points.) Nor does the case present important questions of federal law that this Court should decide, or conflict with the relevant decisions of this Court.

This dispute simply involves a case-specific interpretation of two related terms in the claims of a 3M patent on graphic films, applied to the sides of trucks and buses. The process of interpreting the claims was not difficult because the inventors explicitly defined the claim terms in their patent. While the dissent below viewed the definition differently than did the majority, the dissent never agreed with Petitioner's current position that the claim was in a "product-by-process" format, that the claim language itself required process limitations, or that there was some "agency action" that is entitled to some level of judicial deference. Even Petitioner admitted at oral argument to the appellate court that the claim was not in "product-by-process" format, but instead

contained "process like" elements. And no one, not even Petitioner, ever asserted or even alluded to the APA or to any rule of deference. Instead, until the petition to this Court, all parties and the court worked under the well-settled rules of patent claim construction (though they differed on how the construction should come out, based on the facts).

B. The 3M Invention and Patent

3M's patented adhesive graphics film kills two birds with one stone: it allows an installer to reposition the film during installation (*i.e.*, to straighten the film or remove wrinkles), and it allows the installer to remove air bubbles easily once the film is set in position. *See* U.S. Patent 5,897,930. The invention solves the first problem by providing nonadhesive bumps that stick out from the adhesive on the back of the film so that, until the film is pressed down, it floats up on the bumps over the surface on which it is to be applied. [A487-88][1] The invention solves the second problem (*i.e.*, getting air bubbles out of the applied film) by providing small indented channels in the adhesive through which air can flow after the film is applied to get air bubbles to the edge of the film. [*Id.*]

To place these features in the film/adhesive, the 3M invention starts, not with the film or adhesive, but with the sheet that covers the adhesive and that is peeled away by the installer. This backing is known as a "release liner." [*Id.*] Specifically, 3M's invention comprises a release liner having two superimposed embossed patterns of differing depths—a "multiple embossed pattern." [*Id.*; A48(col. 9, line 34)] Such a structure (greatly magnified) is shown in Figure 3 of the patent (below).

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[1] The Appendix submitted to the Federal Circuit is cited by page number as Axxx.

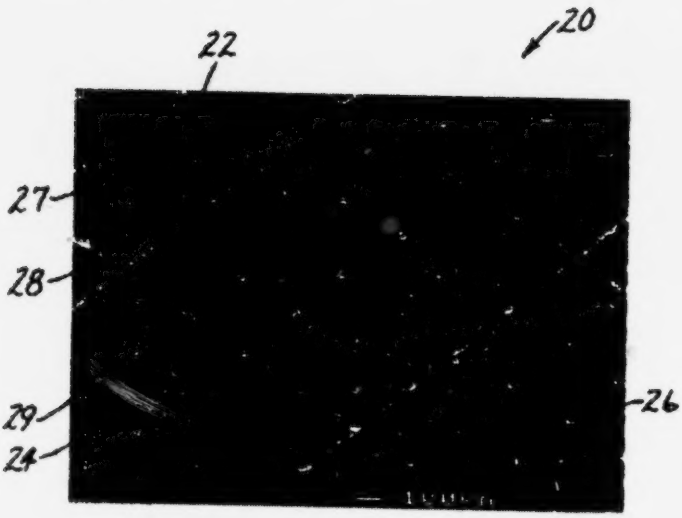

FIG.3

[A43, 45-46(col. 4, lines 66-67)] The liner in this figure has a number of intersecting "ridges" (28). When the liner is pressed onto the back of the film/adhesive, the ridges create corresponding air-release channels in the adhesive. [A487-88] The liner also contains a number of depressions (the dots in the photo) that correspond to the repositioning bumps on the film/adhesive. This liner, or "carrier web," is the structure that the 3M patent recites in the patent claims, and it is the structure by which the Federal Circuit construed the claims.

The 3M inventors left no doubt that the claim terms they used to describe this structure—"embossed," "pattern," and "multiple embossed"—were purely structural, because they chose to be their own "lexicographers" in the patent specification, a well-accepted practice in the patent field.[2] In par-

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[2] *See, e.g., Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed. Cir. 1984); *Universal Oil Prods. Co. v. Globe Oil & Ref. Co.*, 137 F.2d 3, 6 (7th Cir. 1943) ("Plaintiff's right to define the term used in its patent is clear."), *aff'd*, 322 U.S. 471 (1944).

ticular, the inventors explicitly defined each term in the specification using structural language:

> "Embossed" means a topography on a web or on tooling having an effective three-dimensional pattern that generates a difference in surface planar dimension in the liner or the tooling.
>
> . . . .
>
> "Pattern" means any formation of embossings that can utilize any theory of geometry, including without limitation, Euclidian geometry and fractal geometry.
>
> . . . .
>
> "Multiple embossed" means two or more embossing patterns are superimposed on the web to create a complex pattern of differing depths of embossing.

[A44 (col. 1, line 61 to col. 2, line 3)] No definition recites any steps or process by which the defined structures must be created. It is these definitions that the Federal Circuit majority, following years of consistent case law allowing an applicant to be his own lexicographer and define his patent terms, adopted.

C. Prosecution of the 3M Patent

Before the Patent Office, the inventors originally presented patent claims that ***were*** limited to a process having separate, sequential embossing steps. However, after the patent examiner initially rejected the application, the inventors removed that requirement, as shown in the following amended claim 1 of the application, with added language underlined and deleted language stricken:

1. (Amended) A carrier web, comprising:

at least one surface that has a multiple embossed pattern having a first embossed pattern and a second embossed pattern ~~is multiple, sequentially embossed with a pattern,~~ wherein depressions of ~~created from~~ the first embossed ~~prior embossing~~ pattern are ~~patterns(s) are substantially preserved during~~ in the second ~~subsequent embossing pattern(s)~~ embossed pattern ~~even though the subsequent embossing pattern(s) are superimposed on the depressions from the prior embossing patterns(s)~~.

[A110] The inventors removed the requirement for "sequential" steps, removed the requirement that depressions be "created from the prior embossing," and removed the requirement for a "subsequent embossing." Instead, the inventors, post-amendment, simply recited the "carrier web" structure, apart from the process by which it was created. The inventors also pointed out in their comments that the new claim terms—"multiple embossed" and "pattern"—were "defined terms" in the patent, thus pointing up their intent to be lexicographers. [A111]

Notwithstanding the inventors' amendment of claim 1 to eliminate the sequential process language, the patent examiner, in a subsequent communication, referred to claim 1 as "drafted in the product-by-process format." [A121] The examiner's statement is curious because, under longstanding case law and Patent Office rules, process steps in a "product-by-process" claim are not to be considered for determining patentability, so the examiner could not have considered whether process steps in claim 1 distinguished the prior art, even if he was convinced they were there. Even with this additional inconsistency, two things are clear: the applicants never agreed to or acquiesced in the examiner's misstatement, and the characterization of the claim format had nothing to do with the examiner's ultimate allowance of the

claims. Rather, the claims issued only after the applicants added limitations defining the height of the ridges over the land. The examiner identified that structural height addition as the sole basis for allowing the claims to issue. [A133]

During the prosecution, the inventors presented another claim—claim 6—that recited a method or process of embossing and did include certain of the process steps that had been eliminated from claim 1. [*See* A48] Claim 6 has not been asserted in this case, but it underscores that the inventors used process language when they wanted to claim a process (claim 6), and structural language when they wanted to claim an apparatus (claim 1).

D. The District Court Rulings

Shortly after Respondents filed their Complaint in this action, they moved for a preliminary injunction. Petitioner argued that claim 1, although reciting a "carrier web" as a product, should be limited to a carrier web that had been formed using multiple, sequentially embossed patterns. [A971-72] For their part, Respondents pointed out that the patent specifically defines the relevant claim terms in a purely structural manner, that the patent specification distinguishes between "multiple embossed" patterns as a structure, and "multiple, sequentially embossed" patterns produced by the sequential method of unasserted patent claim 6, and that the inventors had removed the "sequential" limitation from claim 1 while prosecuting the patent application. [A1206-08] Nonetheless, the district court accepted Petitioner's argument that the embossed patterns had to have been applied sequentially rather than in one step.

After discovery, Petitioner moved for summary judgment that it did not infringe claim 1. Respondents reiterated their disagreement with the district court's earlier ruling, and identified disputed fact issues even under the district court's

construction. The district court granted Petitioner's motion, stating that it was applying its earlier construction of the relevant claim terms. [Pet. App. 31a] However, the district court actually stated a number of different constructions: it purported to apply the structural definition the inventors wrote in their patent, but it then added a requirement that the topography of the claimed carrier web be created by "impressing a corresponding inverse topography" on the web—a requirement found nowhere in the claims or the inventors' definition. [Pet. App. 32a] The district court then relied on several dictionary definitions, none of which said anything about "impressing" a topography. [Pet. App. 33a-34a] Stranger yet, the district court noted that it was applying its construction from the preliminary injunction proceedings—a definition that did not match the definitions in the patent and that did not require any "impressing."

E. The Federal Circuit Ruling and Denial of Rehearing

The Federal Circuit reversed the district court after holding that the district court improperly imported process limitations into claim 1. The Respondents, in briefing and arguing the appeal, again pointed out that the inventors provided clear definitions of the relevant terms in their patent, and that those definitions should control. For its part, Petitioner focused on alternative grounds for affirming the district court's claim construction. Petitioner argued that the inventors had not adequately shown their intent to define terms such as "embossed." Petitioner also argued that Respondents' proposed construction would make the term "embossed" in claim 1 superfluous, because claim 1 also recites a "pattern . . . of depressions" and a "pattern compris[ing] lands and ridges." But at most, these phrases simply cause some overlap between elements. Such overlap is common and allowable.

Importantly, Petitioner said nothing before the district court or the Federal Circuit about "deference" owed to any "decision" by the Patent Office, and said nothing about the Administrative Procedures Act (APA). At most, Petitioner suggested that the examiner's misdirected statement about "product-by-process" claims was, as part of the intrinsic patent record, relevant to determining the meaning of the claim terms. More important, at oral argument, Petitioner's counsel abandoned even that argument, and asserted only that the claim contained process-like limitations (emphasis added):

> Judge Clevenger: Does the definition [in the patent specification] say anything about how the depression gets created?
>
> Mr. Dorman: Does the…
>
> Judge Clevenger: ..is it punched up from the bottom..
>
> Mr. Dorman: what..no…no…no…
>
> Judge Clevenger: ..or punched up from the top, or [inaudible] go in and blow air in..
>
> Mr. Dorman: This was not a … ***I don't think this was a product-by-process claim***, pursuant to this, but I do think the word embossed…
>
> Judge Clevenger: Did you tell us that in your brief?
>
> Mr. Dorman: Yes, we, in the reply brief, we talked about, we cited *In re Fitzgerald*…
>
> Judge Clevenger: ***Did you tell us it was not a product-by-process claim***?
>
> Mr. Dorman: ***We explained that it was process-like in terms of***…
>
> Judge Clevenger: ***Right, but the district court said it was a product-by-process claim***.

> Mr. Dorman: ***What the judge said below is not determinative of what this court…***
>
> . . . .
>
> Judge Clevenger: I thought you said it was a process…[sic, product-by-process]
>
> Mr. Dorman: It is process-like.
>
> ....
>
> Judge Clevenger: And I guess I should have figured out that that's what you meant when you were citing In re Fitzgerald in footnote 5 on page 31 in your brief; or were you citing Fitzgerald for a different proposition?
>
> Mr. Dorman: Your honor, I apologize for not making this argument clearer. I mean, it's… The ah… But this is….

Petitioner's latest change in theory is thus new to the extent it raises the APA, and contrary to its earlier positions to the extent it argues the claims are in "product-by-process" format.

The Federal Circuit majority, in reaching its decision, started with the claim language as read in light of the patent specification and prosecution history. [Pet. App. 10a] The majority first found error in the district court decision that the recitation of "first" and "second" embossed patterns in the claims required that the patterns had to be formed in sequence. [Pet. App. 11a] The court then recognized that the applicants had defined the claim terms in the patent, and cited case law indicating that such explicit definitions control the claim construction process. [Pet. App. 15a]

The majority also considered the entirety of the prosecution file, including the examiner's misguided comment. [Pet. App. 15a-16a] The majority recognized the interpretive importance of the claim amendment by which the inventors broadened claim 1 to remove any process limitations. [Pet.

App. 13a] And the majority recognized that the examiner's comment, "[i]n this context," could not override the clear meaning of the claims, since the applicants never acquiesced in the comment, and the examiner allowed the patent to issue for reasons unrelated to the comment. [Pet. App. 15a-16a] Thus, the majority based its decision on the particular statements in the patent record and discerned the claim meaning from the entirety of those statements—a case-specific ruling.

The dissent did not suggest that certain deference was owed to the examiner. Rather, the dissent believed that the patent's definition of "multiple embossed," which spoke of "superimposed" patterns, suggested some process. [Pet. App. 21a] The dissent also did not go as far as the district court, which held that the claim was in product-by-process format and included a sequential limitation. Instead, the dissent simply noted that the claim required some process, and noted that the definition of "multiple embossed" did ***not*** require the tools to be applied serially rather than simultaneously. [Pet. App. 22a; Pet. at 13 n.8 (criticizing the dissent)] Thus, even the dissent did not adopt the positions urged by Petitioner here.

Petitioner then moved for *en banc* rehearing, a request that the court denied without any comment or opinion.

REASONS FOR DENYING THE PETITION

I. The Petition Does Not Identify Any Questions that Warrant the Court's Consideration

A. Petitioner Identifies No Basis For Review

This is an ordinary patent case, involving a patent-specific claim construction, that does not fit any of the examples of compelling reasons for a writ of certiorari given in Rule 10 of this Court. There is no circuit split, and there has been no disagreement within the Federal Circuit itself over

the questions Petitioner presents. The issues Petitioner raises, in fact, have nothing to do with any claim construction issue that has caused debate at the Federal Circuit, or with any of the issues discussed in the authorities that Petitioner cites.[3] Also, Petitioner does not argue that the Federal Circuit "has so far departed from the accepted and usual course of judicial proceedings" to warrant this Court's attention, and this appeal is not from a state court of last resort. Sup. Ct. R. 10(a), (b). Finally, the petition does not present a decision on an important question of federal law or on an important federal question. *Id.* 10(c). Petitioner's attempt to paint an ordinary patent case as an administrative law decision, or as establishing a controversial new rule of law, does not demonstrate a compelling reason to grant a writ of certiorari.

B. The Supposed "Agency Action" Here is a Fiction Created to Obtain Certiorari

This case is about patent claim construction in a suit between private parties. It has nothing to do with deference due

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[3] Petitioner's citation of authority is misleading. For example, Petitioner claims, without citation, that the Federal Circuit's claim construction reversal rate is nearly 50%. [Pet. at 2] However, one authority cited elsewhere by Petitioner indicates that between April 1996 and January 2001, the Federal Circuit rejected one or more of a district court's claim constructions in only 33% of cases, and only 81% of those cases were reversed or remanded. [Pet. at 14 n.9, citing Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases*, 12 Fed. Cir. B.J. 1, 10-11 (2002)] Another of Petitioner's sources indicates that, between January 1998 and April 2000, the Federal Circuit reversed 29.6% of cases in which the court expressly reviewed claim construction (excluding Rule 36 decisions, which are all affirmances). Christian A. Chu, *Empirical Analysis of the Federal Circuit's Claim Construction Trends*, 16 Berkeley Tech. L.J. 1075, 1104 (2001).

to administrative agencies. The Federal Circuit was not reviewing a new Patent Office policy or statutory interpretation, nor was it reviewing a decision of the Board of Patent Appeals and Interferences or the Trademark Trial and Appeal Board. Rather, a Patent Office employee simply made a statement, akin to dicta, during the course of examining a patent application. The Federal Circuit considered this statement, as well as other statements made by the examiner and the applicant, and decided how the claims should be construed. The Federal Circuit based its claim construction on all of the evidence it normally considers when interpreting claims. At bottom, Petitioner's complaint is with the outcome of the case, based on its facts as viewed under the court's application of well-settled law, an issue not deserving of this Court's scarce resources.

1. Petitioner Never Raised This "Deference" Issue Before the District Court or Federal Circuit

Petitioner never mentioned the APA or deference to an administrative agency at the Federal Circuit or the district court. Instead, Petitioner properly treated the issue as one of claim construction, as did the courts. Petitioner's failure to even mention, let alone argue, the question of deference under the APA waived its opportunity to ask this Court to consider the issue. *See, e.g.*, *TRW Inc. v. Andrews*, 534 U.S. 19, 33-34 (2001) (rejecting an argument raised for the first time at the Supreme Court because it was not raised or briefed in the lower court); *United States v. Ortiz*, 422 U.S. 891, 898 (1975) (refusing to consider issue raised for first time in petition for certiorari).

Moreover, there is no rational reason that this Court should be the first ever to address the point. Neither the Federal Circuit nor the district court has considered this issue, as neither was given the opportunity to do so by the Petitioner. Petitioner's actions in this case thus simply underscore that

the APA deference issue is a straw man built to secure review of a patent-specific, fact-specific, case-specific ruling.

2. The Examiner's Statement Was Not and Could Not Be an Agency Decision or Finding in Any Event

A patent examiner is charged with determining the patentability of inventions under the Patent Office's guidelines. The examiner's offhand statement here could not be a decision or finding, because it was not related to the patentability of the invention. First, as a legal matter, examiners may not consider process steps in determining the patentability of product-by-process claims. Manual of Patent Examining Procedure (MPEP) § 2113 (citing *In re Thorpe*, 777 F.2d 695, 698 (Fed. Cir. 1985)); *see also Atl. Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845-46 (Fed. Cir. 1992); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1583 (Fed. Cir. 1991). Thus, contrary to Petitioner's repeated attempts to convince the Court that the examiner's statement here was substantive, the statement could not have been. Even if the examiner had decided the claim was in product-by-process format, he could not have used the process limitations to distinguish the prior art. *See Hyatt v. Boone*, 146 F.3d 1348, 1355 (Fed. Cir. 1998) (examiners are presumed to have done their jobs correctly and to have followed all Patent Office rules).

The examiner, in fact, did not allow the claims based on any conclusion about their format. Rather, he provided an explicit explanation on a paper entitled Notice of Allowability, explaining that his basis for allowing the claims related to the claimed heights of the lands and ridges:

> The reasons for withdrawing the rejections of record are as follows: The prior art does not suggest or teach a carrier web with ridges and land that ranges from about 3 to 45 μm.

[A133] Thus, the examiner relied purely on structure, not any view on claim format, in making his determination of patentability.

Apart from the fact that the examiner could not and did not make a decision or finding on claim format, a single comment of a patent examiner is not an "agency action" subject to deferential review. Section 706 of the APA sets the standards governing the scope of a court's review of agency fact-finding. Section 706, which applies to "agency action," states that "the reviewing court shall decide all relevant questions of law." 5 U.S.C. § 706. Section 551(13), a provision ignored by Petitioner, defines "agency action" as "the whole or a part of an agency rule, order, license, sanction, relief, or the equivalent or denial thereof, or failure to act." 5 U.S.C. § 551(13). For example, the decision of the Board of Patent Appeals and Interferences on appeal in *Dickinson v. Zurko* was an agency action. 527 U.S. 150 (1999). Section 706 is not meant to, and does not, apply to a single statement of an agency employee.

Not all undertakings by an agency are "agency actions." For example, the Patent Office's advertising campaign regarding invention promotion scams—an "action" that was more agency-wide, thought-out, and final than the examiner comments here, was not a final agency action subject to review under the APA. *See Invention Submission Corp. v. Rogan*, 357 F.3d 452, 459 (4th Cir. 2004) ("[T]he Administrative Procedure Act does not provide judicial review for everything done by an administrative agency . . . ." (internal quotation omitted)). Importantly, statements of lower-level agency officials are not agency actions subject to judicial review, even when contained in official administrative correspondence. *See Genendo Pharm. N.V. v. Thompson*, 308 F. Supp. 2d 881 (N.D. Ill. 2003). And comments made by agency employees in internal agency documents are not agency actions. *United States v. Farley*, 11 F.3d 1385, 1391 (7th Cir. 1993). Thus, the examiner's passing statement here,

which was part of a voluminous file, and was only one of many comments by the examiner, was properly considered by the Federal Circuit majority along with other intrinsic evidence in the context of construing claim 1, but it was not a Patent Office action entitled to some level of deference.

In contrast, the Federal Circuit applies deferential review when it is appropriate—to actual findings by the Patent Office, in the form of decisions by the Board of Patent Appeals that review decisions by an examiner. *See Dickinson*, 527 U.S. 150. As for review of issued patents, like that here, Congress has explicitly stated in the Patent Act that patents are presumed to be valid. 35 U.S.C. § 282. Implementing the statute, the Federal Circuit has required clear and convincing evidence of invalidity—thus granting deference to the examiner's decision to validate the issued patent. The Federal Circuit, however, has properly distinguished the examiner's action of issuing the patent from an examiner's passing statements, effectively dicta, during the examination process. *See Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1329 (Fed. Cir. 2000) (holding that the district court was not bound by patent examiner's statement, and distinguishing *Zurko* as an appeal from a Patent Office decision). Thus, the Federal Circuit does apply deference when and how it is appropriate. It is not appropriate here.

Petitioner also provides no authority to support its argument that *Zurko*, a direct appeal of a Board of Patent Appeals decision, should be applied to patent infringement litigation between private parties. Sections 704 and 706 of the APA apply to judicial review of an agency action. *See* 5 U.S.C. §§ 704, 706. Section 704 sets out the actions that are subject to judicial review. Section 706 requires a court to examine agency findings of fact carefully before substituting its judgment for that of the administrative agency with expertise in the respective subject matter. A court construing patent claims in an infringement action is not reviewing a Patent Office action to determine whether the agency's statements

about claim construction were appropriate, nor is it substituting its judgment for a decision within the expertise of the Patent Office. Rather, the court is performing the legal process of interpreting the patent document.

Petitioner notes that "patent claim construction has been analogized as a close cousin to statutory interpretation" and quotes *Chevron* at length. [Pet. at 24, quoting *Chevron U.S.A., Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837 (1984)] In *Chevron*, however, this Court "held that a court must give effect to an agency's regulation containing a reasonable interpretation of an ambiguous statute." *Christensen v. Harris County*, 529 U.S. 576 (2000) (holding that an agency opinion letter did not warrant *Chevron*-style deference). The analogy supports Respondents rather than Petitioner. Here, there is no statute that Congress has given the Patent Office authority to interpret. Thus, *Chevron* deference would likely be inapplicable even if the Patent Office adopted a rule on how to construe claims. Deference is plainly inapplicable where the "action" was by an agency staffer, was at most dicta by the staffer, and was not taken under any statute, let alone an ambiguous statute. Thus, there is no practical reason for the Federal Circuit to defer on a legal issue like claim construction.

II. The Federal Circuit's Decision Was Proper Under Any Standard

In stating its second Question Presented, Petitioner misrepresents the decision below. The Federal Circuit did not create a new rule of claim construction. Specifically, it did not hold that past tense verbs must be construed as entirely structural. Rather, the majority did nothing other than examine the claim language in the context of the intrinsic patent record:

> [W]ords of limitation that can connote with equal force a structural characteristic of the product or a process of manufacture are commonly and by default interpreted in their structural senses [sic, sense], unless the patentee has demonstrated otherwise.

[Pet. at 12 (quoting Pet. App. 11a)] The majority then examined the patent specification and file history, and concluded that no one had "demonstrated otherwise." Petitioner's attempt to divine a new rule of claim construction from this case-specific reading of the claim terms and review of the patent file again points up that Petitioner is simply recasting this case into something new.

Apart from this statement, the majority followed standard rules of claim construction that hold a patentee to statements made during prosecution that mattered to patentability, but ***not*** to offhand comments. The examiner here could not, and did not, base his allowance of the 3M patent on the presence of any process steps. And contrary to Petitioner's repeated assertion that the majority "wholly ignored" the examiner's statement, the majority explicitly discussed the statement and considered it in the proper context of the patent file to determine that it could not override the plainly structural nature of the patent claim. [Pet. App. 15a] The Federal Circuit's decision was thus fully consistent with its practice of looking at all the intrinsic evidence from the patent file to determine the proper meaning of the claims. *See, e.g., Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1341-43 (Fed. Cir. 2001); *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir. 1991).

Importantly, in support of its second issue, Petitioner has not cited a single decision of this Court, and has not identified any Federal Circuit decision that conflicts with the majority's approach. Rather, Petitioner simply contends that

some cases cited by the majority do not support the majority's conclusion. [Pet. at 26-27] Likewise, even the dissent below only criticized the majority's review of the facts; the dissent did not cite a single case. [Pet. App. 19a-23a] Petitioner's complaint ultimately boils down to its position that the majority misread the patent-in-suit—a complaint with the application of settled law to specific facts, and not an issue on which this Court should spend its limited resources.

CONCLUSION

For the foregoing reasons, Respondents respectfully request that the Court deny the petition for a writ of certiorari.

Respectfully submitted,

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Supreme Court, U.S.
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IN THE

Supreme Court of the United States

AVERY DENNISON CORPORATION,

Petitioner,

v.

3M INNOVATIVE PROPERTIES COMPANY and
MINNESOTA MINING & MANUFACTURING COMPANY,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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STATEMENT PURSUANT TO RULE 29.6

Petitioner's corporate disclosure statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that statement.

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INTRODUCTION

Despite 3M's attempt to recast the two questions raised by Petitioner, the fact remains that the Federal Circuit's decision, if left untouched, will expand the zone of uncertainty and associated impediments to innovation that currently exist under our patent system. Simply put, innovation cannot flourish when the public lacks both fair notice of the scope of patent rights and the means to predict reliably how a court might construe those rights. With ambiguous rules for determining the scope of patent claims with process limitations, marketplace innovation is frustrated and litigation, regrettably, is promoted.

This case exemplifies a patent system that has turned its back on the statutory fair notice requirement.[1] After the United States awarded 3M a patent entitled "Multiple Embossed Webs," Avery respected 3M's patent and (at great expense) developed a superior single-embossed web, providing the market with competition and choice. By persuading the Federal Circuit Majority to ignore the words elected by 3M to describe its invention—namely, the "embossed" and "multiple embossed" process limitations in 3M's claimed web—(which Avery relied on in designing around and improving graphic film products), Avery now faces continued exposure for its innovation.[2]

3M's opposition to Avery's petition repeatedly describes this case as a simple claim construction dispute involving settled

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1. *See* 35 U.S.C. § 112(2); *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991) (section 112 gives "the public . . . fair notice of what the patentee and the Patent and Trademark Office have agreed constitute the metes and bounds of the claimed invention," allowing "other parties to avoid actions which infringe the patent and to design around the patent.").

2. This same claim language, chosen by 3M to describe its invention, was understood by the Patent Examiner to be written in the "product-by-process" claim format.

principles of patent law. But there are no settled principles of patent law in the area of process limitations in product claims. Moreover, 3M cannot refute that the Federal Circuit, after discarding the Patent Examiner's findings regarding claim format and scope of patented rights thereby created, read the "embossed" requirement out of 3M's "multiple embossed" patent, which is itself contrary to settled principles of patent law. The two issues raised by Petitioner would go far toward restoring fair notice of the scope of patent claims to the public. Contrary to 3M's opposition, review by this Court would provide much-needed guidance to lower courts on these issues.

I. THE QUESTION CONCERNING THE DEFERENCE OWED BY COURTS TO PATENT OFFICE FINDINGS REGARDING CLAIM FORMAT AND THE SCOPE OF RIGHTS THEREBY CREATED IS PROPERLY PRESENTED AND WARRANTS REVIEW

The first question is whether federal courts, in construing the claims of issued patents, should defer to Patent Office findings regarding the format of claims and the scope of exclusive rights thereby created. 3M argues against reviewing this question on the ground that Avery "never raised this 'deference' issue before the District Court or Federal Circuit." Opp. at 12-13. Although Avery did not use the word "deference" in its appeal briefs, this issue is adequately raised under the circumstances of this case.

Plainly, the District Court, in construing the terms used in claim 1, deferred to the Patent Examiner's conclusion that 3M adopted the "product-by-process" format for that claim. App. 50a, 52a. On appeal, 3M did not address the Examiner's statement. Avery, on the other hand, argued that the Examiner's conclusion of product-by-process claim format communicated an understanding that the process words in claim 1 were to be

given process meanings. In response, the Federal Circuit Majority, *sua sponte*, fashioned its rule that "an examiner's characterization of a claim" merits no level of deference absent the "applicant's clear and unmistakable acquiescence to that characterization. . . ." App. 16a. Accordingly, the deference question did not ripen into an issue for review until the Federal Circuit ruled in this case.

Further, once the Federal Circuit fashioned its "clear and unmistakable acquiescence" rule, Avery specifically challenged, in a petition for rehearing, the Federal Circuit's refusal to adopt, as the Patent Office concluded, a process meaning for "embossed" and "multiple embossed." Pet. For Panel Reh'g and Reh'g En Banc at 8-9. This express challenge adequately preserves the issue for review by this Court.[3]

Review by this Court would not be precluded even if Avery had not raised the issue below. The deference question falls well within the category of "exceptional cases" in which the Court declines to "limit [its] power to decide important questions not raised by the parties . . . particularly in cases arising in the federal courts." *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 320 n.6 (1971).[4] Considering the

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3. *See Richards v. Jefferson County*, 517 U.S. 793, 797 n.3 (1996) ("Because petitioners raised their due process challenge to the application of res judicata in their application for rehearing to the Alabama Supreme Court, that federal issue has been preserved for our review."); *City of Houston v. Hill*, 482 U.S. 451, 467 n.16 (1987) (city's failure to raise abstention issue until after it had lost on the merits before the Court of Appeals did not bar Supreme Court from considering the issue).

4. Indeed, in many instances, this Court has considered issues not squarely presented in the courts below. For instance, in *Carlson v. Green*, 446 U.S. 14 (1980), the Court decided a question presented in a petition for certiorari that had not been raised in the lower courts where, as here, the issue was squarely presented in the petition, was important and

(Cont'd)

astonishingly high reversal rate of district court claim construction rulings, and the corresponding "zone of uncertainty" that deprives the public of rights "without being clearly told what it is that limits these rights," *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996), there is an exceptional need for guidance from this Court on the first issue presented for review.

3M's remaining arguments against review of the deference question are no more compelling. For example, 3M argues extensively that the deferential standard contained in section 706 of the Administrative Procedures Act ("APA") does not apply to statements by patent examiners in the public examination record because those statements do not qualify as an "agency action." Opp. at 14-15 (citing 5 U.S.C. § 551(13)). Yet 3M overlooks that the deference demanded in section 706 extends beyond "agency actions" and includes "findings and conclusions." 5 U.S.C. § 706(2). 3M cites no authority holding that a patent examiner's statements regarding claim format and scope of patentable rights thereby granted fall outside the scope of an agency's "findings" or "conclusions".

Similarly, 3M repeatedly misstates the first of the two questions that Avery presents. The first question presented in Avery's petition is not whether the APA or statutory construction rules should apply to patent claim interpretation. It is whether the public can rely on a patent examiner's statements regarding claim format in determining the scope of exclusive rights granted

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recurring, and "the interests of judicial administration [would] be served by addressing the issue on its merits." *Id.* at 17 n.2. *See also Vance v. Terrazas*, 444 U.S. 252, 259 n.5 (1980) ("consideration of issues not present in the jurisdictional statement of the petition for certiorari and not presented in the Court of Appeals is not beyond our power, and in appropriate circumstances we have addressed them"); *Capital Cities Cable, Inc. v. Crisp*, 467 U.S. 691, 696 (1984); *Virginia Bankshares, Inc. v. Sandberg*, 501 U.S. 1083, 1098 (1991); *Lebron v. National R.R. Passenger Corp.*, 513 U.S. 397 (1995).

to a successful patent applicant, or whether such statements can be ignored absent an express, written concurrence by the patent applicant. For this reason, 3M's citation to *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1329 (Fed. Cir. 2000) is misplaced. Opp. at 15. Unlike the first issue presented here, the *Purdue* court ruled, not surprisingly, that district courts are not "bound" by a patent examiner's written statement confirming that proposed claims satisfy the written description requirement of 35 U.S.C. § 112. *Id.* at 1329. Indeed, the Patent Act expressly includes the failure to comply with the written description requirement as a defense to infringement actions. 35 U.S.C. § 282.

Substantively, 3M argues that deference should not be conferred, citing cases regarding statements of "lower-level" agency officials and comments in "internal agency documents." Opp. at 14. But patent examiners cannot be considered "lower-level" agency officials. To the contrary, patent examiners often make the final determination on whether to provide a federal grant of exclusive rights to a patent applicant along with the precise scope of those rights. Nor do the examiner's statements, which reflect the Patent Office's views about claim format and scope of rights, appear in "internal agency documents." Instead, those comments are included in the public "file wrapper" for each granted United States patent so that the public can better understand what can and cannot be done without infringing. *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966) ("It is, of course, well settled that an invention is construed not only in light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office.")

3M also argues that the question of deference to the Patent Examiner's conclusions regarding claim format should not be reviewed in this case because the statement "was not related to the patentability of the invention." Opp. at 13. In support, 3M cites the rule that process steps are not considered in determining the patentability of product-by-process claims. *Id.* (citing MPEP § 2113). 3M's argument fails both legally and factually.

While 3M correctly notes that the Examiner could not consider *how* the web of claim 1 was embossed in determining patentability, nothing in the MPEP or case law barred the Examiner from recognizing, in his patentability decision, that the web of claim 1 is "embossed." Indeed, the Patent Examiner considered only prior art in the embossing field in determining patentability. [A0041.] Moreover, the Examiner twice rejected proposed claims on the basis of prior art disclosing embossed webs in which a tooling process impressed a pattern. [A0065-0146.] When the applicants then amended their claims to recite a ridge height limitation, they did so ***in combination*** with the product-by-process limitations—"embossed" and "multiple embossed"—already in the claims. Just because the applicants added a structural height limitation to distinguish otherwise invalidating prior art does not mean that the Examiner's "product-by-process" determination was unrelated to the patentability decision. To the contrary, the claim language upon which the Examiner based the product-by-process determination was as essential to patentability as all other claim limitations.

Finally, 3M contends that Avery, during the Federal Circuit argument, "abandoned" the position that 3M used the "product-by-process" claim format. Opp. at 8-9. Avery abandoned nothing. Avery's counsel responded to a specific panel question regarding how the definition of "embossed" in the patent specification related to the District Court's construction. Avery's counsel explained that the District Court's determination of non-infringement did not turn on whether 3M used the "product-by-process" claim format, so long as the term "embossed" was construed in its normal, process-like sense. Under long-settled law, structure claims can use process-like terms. When structure claims use process-like terms, the process terms are not only given meaning, they are construed as a process. Oppos. Brief of Appellee at 31-32 (citing *In re Fitzgerald*, 619 F.2d 67, 69-70 (CCPA 1980) and E.P. Mirabel, *Product-by-Process Claims: A Practical Perspective*, 68 J. Pat. & Trademark Off. Soc'y 3 (1986)).

II. THE DECISION BELOW DEPARTS FROM FUNDAMENTAL CLAIM CONSTRUCTION DOCTRINES

The second question is how federal courts should construe product claims that have process limitations—descriptive both of structure and the way in which the structure is created—in accessing infringement and validity. This stated question does not "misrepresent" the decision below.

3M argued, and the panel Majority agreed, that "embossed" and "multiple embossed," as used in claim 1, are "entirely structural" and "describe[] only a structural relationship." App. 11a, 17a. The problem 3M now faces, and cannot explain, is that the terms "embossed" and "multiple embossed" communicate no identifiable "structure" in addition to the structure already provided by other limitations in claim 1. In other words, because the panel Majority's construction completely ignored the process inherent in the terms "embossed" and "multiple embossed," the Majority's construction reads these terms entirely out of the claim—violating at least one settled rule of claim construction. *See Techsearch L.L.C. v. Intel Corp.*, 286 F.3d 1360, 1373 (Fed. Cir. 2002).

Because 3M cannot deny that the Federal Circuit's "structural" construction reads the terms "embossed" and "multiple embossed" out of the claims, 3M opposes the petition on several grounds unrelated to the question presented. Each ground lacks merit.

First, 3M argues that the Federal Circuit's instructions for interpreting terms "that can connote with equal force structural characteristics of the product or a process of manufacture" did not create a new rule of claim construction. Opp. at 16-17. Rather, we are told, the Federal Circuit simply found that the patentees had not "demonstrated" that the terms "embossed"

and "multiple embossed" should be construed as a process. This argument is troubling indeed and confirms the need for review of the second question presented. The fair notice requirements of the patent system contemplate that words have their ordinary meaning unless a different meaning ascertained from the intrinsic patent documents is clearly intended. But the Federal Circuit's "structural presumption" rule would disregard process words whenever used in adjective or past tense verb form to describe a product (*e.g.*, "welded"). Simply put, the structural presumption rule cannot apply for many process terms, irrespective of a patentee's demonstration.[5] In this area, the law needs clarification.

3M's next argument urging this Court not to grant review of the second issue lacks merit as well. 3M contends that the examiner did not base the allowance of claim 1 "on the presence of any process steps." Opp. at 17. In other words, 3M suggests that the examiner would have allowed claim 1 even if the words "embossed" and "multiple embossed" were not used. 3M's contention is demonstrably inaccurate. The examiner consistently referred to the invention as including an embossing process and considered only prior art disclosing embossed webs. [A0101-105 and 0117-124.] At no time did the examiner express that embossing was anything other than an integral feature of the claimed invention. Construing claim 1 in a manner that extends the scope of claim 1 to webs that have never been embossed undoes the entire concept of fair notice.

Finally, 3M asserts that Avery does not cite any decision of this Court or the Federal Circuit conflicting with the "default structural" rule. Avery did cite several conflicting Federal Circuit

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5. Here, for example, 3M chose the word "embossed," which it repeatedly used throughout claim 1 and which unmistakably communicates a process, not structure. Without a process meaning, the term "embossed" is rendered superfluous because a "structural" meaning adds no structure to the language of claim 1 beyond the structure already described.

cases, including *Hazani v. United States Int'l Trade Comm'n*, 126 F.3d 1473, 1479 (Fed. Cir. 1997). Even without conflicting cases, review should be granted because lower courts lack guidance as to how, in product claims, structural limitations should be differentiated from process terms, and when process terms must be given their normal, process meaning. Without guidance from this Court, lower courts will continue to disagree—as the Majority and Dissent did below—and the public will remain in the dark about the risk of patent litigation. The issue meets the criteria for this Court's resources.

CONCLUSION

For the foregoing reasons along with the arguments made in the Petition for Certiorari, Avery respectfully requests that the Petition be granted.

Respectfully submitted,

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